

***United States Court of Appeals
for the
District of Columbia Circuit***



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BRIEF FOR APPELLANT AND JOINT APPENDIX

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 18,087

RADIATOR SPECIALTY COMPANY,

v.

DAVID L. LADD,
Commissioner of Patents,

Appellant,

918A

Appellee.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

United States Court of Appeals
for the District of Columbia Circuit

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STATEMENT OF QUESTIONS PRESENTED

1. Whether "MOTOR-MEDIC" in slanting block letters is registrable over a registered trademark consisting of a red oval background with a caricature of a diminutive doctor in uniform holding aloft a can above which appears "AUTO-MEDIC" in yellow letters, both marks being applied to lubricating oil additives.

2. Whether in denying registration the Patent Office and the District Court improperly relied solely upon the alleged similarity of the terms "MOTOR-MEDIC" and "AUTO-MEDIC", disregarding the design features associated with the terms.

3. Whether, despite the alleged similarity of the terms "MOTOR-MEDIC" and "AUTO-MEDIC" as held by the District Court, that court may properly refuse registration when it finds that a side-by-side comparison of the two terms would properly distinguish them but that prospective purchasers are not always afforded the opportunity of making such comparisons.

4. Whether appellant's \$2-1/2 million in sales of 6,600,000 units sold through 200,000 service stations and \$600,000 in advertising, since September 1958 in competition during at least the last two years with the product of the registrant with overwhelming testimony as to absence of confusion should have been disregarded in favor of the Court's subjective opinion and reliance upon testimony of one witness as to one alleged hearsay incident of confusion.

5. Whether the District Court properly refused to consider and admit evidence as to the specific nature of the mark of the registration upon which plaintiff's application was refused.

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COMMISSIONER OF PATENTS,

Appellee.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

BRIEF FOR APPELLANT

JURISDICTIONAL STATEMENT

This is a proceeding by an applicant seeking registration of a trademark in the United States Patent Office. The applicant, being dissatisfied with the decision of the Trademark Trial and Appeal Board of the Patent Office, has proceeded with its civil action under Title 15, U.S.C. Sec. 1071 (Act of July 5, 1946, c. 540, 60 Stat. 427, as amended by Public Law 593, July 19, 1952, 66 Stat. 792, par. c of Public Law 609, August 8, 1958, 72 Stat. 540, and Public Law 772, October 9, 1962, 76 Stat. 769).

Jurisdiction of the District Court is based upon Title 28, U. S. Code Sec. 1338 (c. 646, June 25, 1948, 62 Stat. 931).

This Court has jurisdiction under Title 28, U.S.C. Sec. 1291 (c. 646, June 25, 1948, 62 Stat. 929; c. 655, Sec. 48, October 31, 1951, 65 Stat. 726; Pub. L. 85-508, Sec. 12(e), 72 Stat. 348), supported by the timely notice of appeal (JA 64).

The complaint (JA 2) and answer (JA 3) respectively allege and admit the requisite jurisdictional facts.

STATEMENT OF CASE

On September 24, 1958, plaintiff-appellant filed its application in the United States Patent Office to register the trademark MOTOR-MEDIC in slanting block letters, such mark having been used by it since a date shortly prior thereto (Plaintiff's Exhibit 1, page 1; JA 45). The specimen filed with the application indicates that the mark is used in an elongated block form slantingly upwardly from left to right (Plaintiff's Exhibit 1, pages 4, 5; JA 47, 48). The application was rejected, based upon a registration, No. 651,646, dated September 17, 1957, for a trademark of Wynn Oil Company. The registered trademark (Defendant's Exhibit 1, JA 60) consists of an oval red background with a caricature of a diminutive doctor in uniform at one side holding aloft a can above which appears the term AUTO-MEDIC in yellow color. The goods, in each case, are lubricating oil additives.

Thus, the issue presented is whether under Section 2(d) of the Trade-Mark Act of 1946, as amended (15 USC 1052; 60 Stat. 427, as amended by 76 Stat. 769), the mark sought to be registered so resembles the registered mark "as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive".

In the Patent Office action of September 12, 1960 (JA 49), the examiner Finally refused to grant registration, stating inter alia:

"It appears that the word MEDIC is the most prominent feature of both applicant's and registrant's marks and it is believed that purchasers would be more likely to remember the prominent features as indicating the origin of the goods."

Thereafter applicant presented argument and another action was mailed on March 23, 1961 (JA 50) in which the rejection was repeated, the examiner relying on In re Fishery Products, Inc., 125 USPQ 533 ("Ocean Club" for frozen fish held confusingly similar to "Sea Club" for canned salmon); and on decisions previously cited, viz. Pesquera del Pacifico, S. De R.L. v. Hardee, 115 USPQ 359 (OCEAN GARDEN and SEA GARDEN held confusingly similar); and Grate, dba Grate Machine Co. v. Mohawk Engineering Corp., 122 USPQ 407 (MITY-MULE with mule held likely to be confused with QUAKER MULE on different mule).

Thereupon an appeal was taken to the Trademark Trial and Appeal Board. The examiner's statement to the Board substantially repeated the prior grounds of rejection. Such statement (JA 51, 52) included the following:

"As applied to automobile motor oil additives, the words AUTO and MOTOR have very little trademark significance. Both AUTO and MOTOR are commonly used as component parts of many trademarks. It is believed that the terms 'auto oil additives' and 'motor oil additives' have substantially identical meanings. On the other hand, the word MEDIC as applied to oil additives, is arbitrary and has no particular meaning. The word 'medic' is defined as (a) 'a physician' and (b) 'a medical student'."

"It is believed that use of the terms AUTO-MEDIC and MOTOR-MEDIC on automobile motor oil additives by different parties would be very likely to cause confusion in trade as to origin of such goods. It is true that a side by side comparison would probably distinguish between these two marks but prospective purchasers are not always afforded the opportunity of making such comparisons. * * * "

The decision (JA 53, 54) of the Trademark Trial and Appeal Board affirmed the refusal of registration, stating:

"The compound terms 'MOTOR-MEDIC' and 'AUTO-MEDIC', as applied to goods identical in kind, have the same meaning and create the same commercial impression. Confusion among purchasers would be more than likely to occur."

Thereupon a complaint was filed in the District Court (JA 2) under the provisions of the statutes.

The trial of the case commenced at 10:00 a.m. and concluded at 12:10 p.m. of June 5, 1963, with opening statements, the testimony of seven witnesses, the offer of a number of exhibits, final arguments, and an oral decision from the bench.

Appellant's Vice President, Herman Blumenthal, testified that both plaintiff company and the registrant Wynn Oil Company are nationally known and have been in business for many years. Plaintiff has over 6,000 active accounts on its books and over 80 exclusive salesmen. At the time that plaintiff placed its product on the market, Blumenthal stated that Wynn's product was not on the market (JA 38-A). The witness stated that his company's policy is to keep informed as to competitive products and that he does considerable traveling and has never known of any instance of confusion with the Wynn product (JA 39).

Plaintiff's General Sales Manager, David Hoffman (JA 25), testified that during World War II stretcher bearers were known as "medics". The Court, therefore, stated that it would take judicial notice that the term "medic" is used very generally and in many different connotations (JA 26). The witness stated that he spent most of his time traveling throughout the country calling on key accounts, mainly automotive (JA 26). Plaintiff's product is sold nation-wide and throughout the world through approximately 6,000 distributors, who serve approximately 200,000 service stations (JA 28). Beginning in September, 1958, through 1962, approximately four and a quarter years, plaintiff's sales of the product amounted to approximately two and a half million dollars for approximately 6,600,000 units.

During that time some \$600,000 was spend in advertising in newspapers, television and trade publications, posters, mailing and display racks (JA 30). The witness has known of Wynn Oil Company approximately fifteen years (JA 30, 31). At the time that plaintiff adopted its trademark it did not know of a product bearing a trademark which included "AUTO-MEDIC", the registration having come to plaintiff's attention for the first time when it was relied upon by the Patent Office (JA 31). Plaintiff's first knowledge of actual use of the composite trademark by Wynn Oil Company was late 1960 (JA 32). The witness stated that he had received no reports of instances of confusion as a result of plaintiff's use of its trademark and the use by Wynn Oil Company (JA 33), despite special inquiry as to such matter addressed to the plaintiff's salesmen (JA 33, 34).

The witness identified (JA 37) Plaintiff's Exhibit 7, an advertisement of Wynn Oil Company of 1956 (JA 55), Plaintiff's Exhibit 8, an advertisement of Wynn Oil Company from the Alberta Advertising Retailer News of December 1960 (JA 56), and Plaintiff's Exhibit 9, plaintiff's catalog (the cover and page 5 of which are reproduced at JA 57, 58). The 1956 advertisement (Exhibit 7) does not disclose use of the composite registered trademark, although it discloses a doctor caricature.

John Henry Parater, the President of Phelps-Roberts Corporation, a wholesale distributor of automotive parts, accessories and related items (JA 11), testified that his company distributed a broad variety of automotive chemicals (JA 12). He did not know of any instance of confusion between plaintiff's product and that of the registrant Wynn Oil Company and until recently had not heard of the product of Wynn, although he had been selling plaintiff's product for about four years (JA 14).

Z. Steve Giannakis testified that he is the Assistant Manager of Columbia Garage, which specializes in taxicab and auto repairs (JA 14, 15). He has been with the company for approximately two years and remembers that it sold plaintiff's product when he first commenced such employment (JA 16). His company makes occasional sales of the product of Wynn Oil Company referred to as "AUTO-MEDIC". No instance of confusion has ever come to his attention (JA 16).

Edward Younes testified that he is the General Manager of National Auto Service Company in Washington, D. C., an automotive parts wholesaler (JA 17). He is familiar with various products of the plaintiff and of Wynn Oil Company (JA 18). His company has five traveling salesmen, who have handled plaintiff's MOTOR-MEDIC product for a number of years and no instances of confusion or complaint or reports of conflict between the product of the plaintiff and that of Wynn Oil Company have come to his attention (JA 20, 21).

Horace Walker, Publisher and Editor of Masthead Publishing Company of Washington, D. C. (JA 22), is familiar with plaintiff company and Wynn Oil Company, having visited various outlets at which their products have been displayed and having arranged for and assisted in publicizing the products of these companies over the years (JA 22). He identified a publication published by his company, "The Automotive Service Station--Today", of June 1963, of which page 20 (Plaintiff's Exhibit 11, JA 59) contains display material of both plaintiff and Wynn Oil Company (JA 23). The witness had never known of any instance of confusion between the products involved herein (JA 24).

Frank Marzullo, operating a service station and auto repair shop, testified that he had not known of any instance of confusion himself, but testified further (JA 29):

"A customer came in and asked for a can of Wynn's Motor-Medic and we told him we didn't have Wynn's Motor-Medic. We told him we had different brands. And this was an employee of mine that told me that this morning."

Various exhibits were offered by plaintiff but were refused as irrelevant. These included containers with plaintiff's trademark applied thereto (Exhibits 2, 3, 4) and the top of a container from the file of the registration of Wynn Oil Company illustrating its trademark applied thereto (Exhibit 5, JA 35-37). Further, plaintiff offered a scrapbook in which appeared numerous advertisements of its product, but this also was refused (JA 38).

At the close of the testimony and argument, the Court handed down an oral opinion from the bench (JA 43), and subsequently the written Memorandum Opinion was rendered (JA 61) and the judgment (JA 64).

STATUTE INVOLVED

Act of July 5, 1946, c. 540, 60 Stat. 427, As amended by Act of October 9, 1962, 76 Stat. 769, U.S.C. Title 15, Sect. 1052 (Sect. 2(d) of The Trademark Act of 1946, as Amended).

"No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it — * * *

* * *

"(d) consists of or comprises a mark which so resembles a mark registered in the Patent Office or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive * * *."

STATEMENT OF POINTS

1. The District Court erred in viewing the issue as involving only the terms "MOTOR-MEDIC" and "AUTO-MEDIC" and holding that registration of the former term should be denied in view of alleged similarity to the latter term.

2. The District Court erred in refusing to consider the specific nature of the mark of the registration on which the refusal was based.

3. The District Court erred in viewing the issue as merely the question of the similarity of the terms "MOTOR-MEDIC" and "AUTO-MEDIC", and further in holding that despite differences sufficient to properly distinguish them in a side-by-side comparison, plaintiff's mark is unregistrable because prospective purchasers are not always afforded the opportunity of making such comparisons.

4. The District Court erred in holding that in comparing the marks the terms "Auto" and "Motor" have very little significance and that the word "Medic" has no particular meaning.

5. The District Court erred in its erroneously accepting and following almost literally the holdings of the Patent Office and in failing to recognize that the evidence presented of the absence of confusion and the absence of the likelihood of confusion was of a character and amount that carried thorough conviction.

SUMMARY OF ARGUMENT

Both the Patent Office and the District Court misconstrued the issue. Both based their decisions on the alleged similarity between the words MOTOR-MEDIC and AUTO-MEDIC. Neither gave appropriate consideration (if, indeed, any) to the significance of the composite trademark of the registration. To disregard the design features of the registration and thus to fail to consider it in its entirety was clear error. The presumptions normally attached to concurrent findings of the Patent Office and the District Court accordingly are not present.

The District Court recognized that a side-by-side comparison of the word portions of the marks would properly distinguish them, but held that prospective customers are not always afforded the opportunity of making such comparisons. The law does not require that there be a 100% absence of likelihood of confusion as the decision appears to hold.

The average purchaser of a lubricating oil additive is not likely to be confused by the simultaneous use of plaintiff's slanting block letter trademark MOTOR-MEDIC and the registrant's trademark consisting of a red oval background with a caricature of a diminutive doctor in uniform holding aloft a can above which appears AUTO-MEDIC in yellow letters.

ARGUMENT

I.

The District Court and the Patent Office Erred in Viewing
The Issue as Concerning Merely the Terms MOTOR-
MEDIC and AUTO-MEDIC Instead of Considering the Marks
In Their Entireties with Their Design Features.

Plaintiff-appellant is aware of its burden resulting from the concurring decisions of the Patent Office and the District Court; Esso Standard Oil Company v. Sun Oil Company, 97 US App DC 154, 225 F 2d 37, 108 USPQ 161, cert. den. 351 U.S. 973.

It appears clear that in the present case both the Patent Office and the District Court erred in their views of the issue. Such error lay in their regarding the issue as involving merely the similarity of the word portions of the marks and attributing no significance to their design features, especially of the registered trademark (Defendant's Exhibit 1, JA 60). Clearly the issue is whether the trademark sought to be registered consisting of MOTOR-MEDIC as it appears on the drawing at JA 48 is so similar to the registered mark as it appears on the registration (Defendant's Exhibit 1, JA 60) as to be proscribed under Section 2(d) of the Trademark Act. In the Patent Office examiner's action, from the certified file wrapper, Plaintiff's Exhibit 1, page 9, Paper No. 3, states, inter alia:

"It is believed that MOTOR-MEDIC and AUTO-MEDIC, as applied to additives for lubricating oil, have substantially the same meaning and create the same commercial impression."

In the examiner's action, page 12, Paper No. 5 (JA 49) the substance of the foregoing basis for rejection was repeated.

In the examiner's statement, page 26, Paper No. 11 (JA 51), reference is again made to the word portion of the mark without any reference to the design features of the mark of the registration.

In the decision of the Trademark Trial & Appeal Board (JA 53), refusal is again based entirely on alleged similarity of the word portions of the marks, no consideration being given to design features.

At the trial, plaintiff's counsel emphasized the design features of the registration of Wynn Oil Company in his opening statement. At that time counsel attempted to acquaint the Court with the composite mark of the registration No. 651, 646 by offering to show the Court a specimen (Exhibit 5) from the file of that registration. The specimen is the lid of a can on which appears the Wynn Oil Company trademark. At JA 6, last three lines, and JA 7, lines 1-8, counsel offered to submit the specimen to the Court. On the same page at lines 13-15 counsel again referred to the composite nature of the mark of the registration. At JA 8, lines 21-23 counsel again attempted to invite attention to the specimen.

During the proceedings the specimen (Exhibit 5) was offered but its admission was refused (JA 35, last six lines to JA 37, lines 1-4).

In his closing argument reference was again made to the composite nature of the registration (JA 40, lines 15-18).

In the ruling delivered orally from the bench (JA 43), the Court stated:

"We have 'AUTO-MEDIC' registered.

"We have 'MOTOR-MEDIC' sought to be registered."

* * *

"The Court has read the decisions of the two Patent Office tribunals and agrees with them. As a matter of fact, the Court cannot imagine any two terms that are so likely to cause confusion, considering the purpose for which they are used, which is practically identical, than AUTO-MEDIC and MOTOR-MEDIC."

In its Memorandum Opinion, filed June 28, 1963, three and a half weeks after trial, the Court stated (JA 61):

"Plaintiff filed his application in the Patent Office on September 24, 1958, in which he asserted use of 'MOTOR-MEDIC' since September 12, 1958. Subsequent thereto,

the Patent Office, in pursuance of Section 2(d) of the Act of July 5, 1946 (15 U.S.C. 1052(d) refused registration on the ground that the mark of plaintiff's application so resembled the compound mark 'AUTO-MEDIC' previously registered for lubricating oil additives (Registration No. 651,646, issued September 17, 1957 to Wynn Oil Company) as to be likely to cause confusion, mistake, or deception to purchasers.

"It is plaintiff's contention that 'MOTOR-MEDIC' and 'AUTO-MEDIC' neither look nor sound alike, and their meanings are sufficiently dissimilar to avoid confusion."

A careful examination of the two opinions of the Court fails to reveal reference to the design features of the registered trademark. On the other hand, such examination reveals that the Court disregarded the design features and considered only the question of similarity of the word portions of the marks themselves. This is clear error.

The decisions of this Court leave no doubt that it is well settled that in determining the question of likelihood of confusion trademarks must be considered in their entireties, including the design features.

In McGraw-Hill Publishing Co. v. American Aviation Associates, Inc., 73 App DC 131; 117 F 2d 293; 47 USPQ 494 (1940), differences in the layouts of the printed titles of publications "AVIATION" and "AMERICAN AVIATION" were relied upon as sufficient to distinguish. This Court's comment in footnote 3 of Philadelphia Inquirer Co. v. Coe, A., Comm'r. Pats., 77 App DC 39; 133 F 2d 385 (cert. den. 318 US 793, 63 S.Ct. 993) might imply a difference in the issue involved in an infringement and a registration case. However, the present trademark statute appears to apply the same test, namely whether confusion, mistake or deception is likely to result. (Compare Section 2 of the Trademark Act of 1946 as amended (15 USC 1052) with Section 32(1) (15 USC 1114(1)) (Act of July 5, 1946, c 540, 60 Stat 427, amended October 9, 1962, 76 Stat 769).

In Frick-Gallagher Mfg. Co. v. Ro-Tray Corp., 74 App DC 315; 122 F 2d 81; 50 USPQ 431 (1941), the Court considered the composite

features of emblems which included the words "ROTABIN" and "RO-TRAY" in holding the composite marks not confusingly similar as applied to rotary steel shelving.

In Pure Oil Co. v. Pep Boys - Manny, Moe & Jack, 76 App DC 19; 128 F 2d 34; 53 USPQ 508 (1942), the Court recognized the descriptiveness of "PEP" as applied to lubricating oils, greases, lubricants, gasoline and fuel oil, and considering the distinctive lettering and caricatures in the marks sought to be registered, affirmed the District Court's decision granting registration of the corporate name in distinctive lettering together with caricatures over the marks "WOCO PEP" for gasoline and "PEP" for gasoline and fuel oil.

The differences between "Medico Pedic" and "Practipedic" coupled with the complete dissimilarity in the appearance of the marks led to this Court's affirmance of a holding of registrability of the former, in Scholl Manufacturing Co., Inc. v. Schiff Co., 81 App DC 324; 158 F 2d 101; 71 USPQ 290 (1946).

Again, in Marzall v. Cook, 90 App DC 404; 196 F 2d 241; 93 USPQ 149 (1952), this Court affirmed the decision of the District Court granting the registration of "JOCO'S" with the smaller "TREASURE CHEST", "TREASURE" being disclaimed, as not confusingly similar to "JACCO" on a shield.

Recent error by the Patent Office of the nature described resulted in a reversal of its decision by the Court of Customs and Patent Appeals in Cooperative Quality Marketing, Inc. v. Dean Milk Company, 314 F 2d 522, 136 USPQ 644 (decided March 13, 1963). The Court's decision indicated clear error on the part of the Patent Office in considering only the word portions of the marks (DAIRY CHARM and COUNTRY CHARM).

In view of the holdings below plaintiff has asserted and continues to assert that the word portions of the marks are not similar within the proscription of the statute. However, such question of similarity does not embrace the true issue, and the deciding of the case on that basis is

erroneous. Hence, there is clear error in the decisions both of the Patent Office and the District Court, and there should be no presumption of correctness.

The cover of Plaintiff's Exhibit 9 (JA 57) illustrates the manner of display of products such as those under consideration. The Court can take judicial notice that such displays are commonplace. Hence, we have a situation where the design features of a trademark cannot properly be disregarded. The prominent oval red background of registrant's registration and the attention-inviting caricature of a doctor holding aloft a can are features which would be likely to make a significant impression upon the purchaser. The medical doctor caricature of the registration is the carrying forward of a caricature used earlier by registrant and exemplified by Plaintiff's Exhibit 7 (JA 55) showing a stork bringing a 1957 model automobile to a doctor, whose advice is to "baby" the car from the start with various products of Wynn Oil Company as the best medicine. The doctor motif is further exemplified in Plaintiff's Exhibit 8 (JA 56), an advertisement of Wynn Oil Company in which the caricature doctor is displayed in the advertisement beside a can of defendant's product. All of the cans shown in Exhibits 7 and 8 bear the prominent designation "WYNN'S", although such does not appear in this company's registration. It may be observed that plaintiff's slanting use of MOTOR-MEDIC (JA 47, 48, 58) does not simulate the layout of AUTO-MEDIC on the registration (JA 60) and that it is applied to a different background.

II.

The Large Sales by Plaintiff in Competition with the Registrant and the Overwhelming Testimony of Lack of Confusion Indicate an Absence of a Likelihood of Confusion, Despite the Single Instance of Hearsay Testimony Tending to Indicate Confusion.

Plaintiff has had large sales and promotion of its product over a period of more than four years, and despite the fact that plaintiff and Wynn Oil Company are competitors no instance of confusion has come

to plaintiff's attention nor to that of any of the witnesses except for the hearsay testimony of a garage operator who said that an employee told him that a customer asked for a can of Wynn's MOTOR-MEDIC. This single instance, based on hearsay, should not be accorded substantial weight, in view of the testimony of the other witnesses as to an absence of any reports of confusion.

III.

Since, as Found by the District Court, a Side-by-Side Comparison of the Terms MOTOR-MEDIC and AUTO-MEDIC Would Properly Distinguish Them, There Is No Reasonable Likelihood of Confusion.

Significantly, in the Memorandum Opinion the District Court stated (JA 62):

"While it is true that a side-by-side comparison of these two terms would properly distinguish them, prospective purchasers are not always afforded the opportunity of making such comparisons, and the Court finds that the use of these two terms would be very likely to cause confusion, mistake, or deception to purchasers."

The foregoing is a recognition by the court below that if purchasers would visually compare the word portions of the marks they would properly distinguish them. But the Court holds that prospective purchasers are not "always" afforded the opportunity of making such comparisons. The statement appears to indicate that in deciding the issue the Court must reject the application unless the circumstances are such that the purchaser is "always" in a situation to avoid being confused. However, the Trademark Act does not require 100% absence of likelihood of confusion. Refusal of registration is based on likelihood or probability of confusion (Section 2(a) of the Trademark Act of 1946, as amended). Hence, the Court has not applied the proper rule. Nor has the Court made any finding that the purchasing habits of the public are such that in ordinary circumstances the customer would not have an opportunity to see the

product or its display or that the customer would rely only on his memory of the word portion without any reference to the design portions.

It is submitted that in comparing the mark sought to be registered with that of the registration there is no reasonable likelihood of confusion of purchasers. The mental impressions created by the marks are significantly dissimilar. The mere fact that both marks include, inter alia, the word "medic", a common word, does not result in a likelihood of confusion. The word portions of the marks have dissimilar prefixes. Although both "auto" and "motor" have many connotations, their differences are of sufficient significance that in the over-all picture there is no likelihood of confusion under the statute.

IV.

The Term "MEDIC" and Variations Are So Commonly Used That It Would Not Be Strongly Relied Upon as an Indication of Origin.

The District Court held (JA 62):

"The word 'Medic' has been defined as a 'Physician' and a 'Medical Student'. As applied to oil additives, the word 'Medic' has no particular meaning.

"The most significant and prominent phase of both of the above-mentioned marks is the word 'Medic', and it would be very likely that prospective purchasers would be more likely to remember the prominent feature as indicating origin of the goods."

It would seem reasonable that with the widespread use of "medicine", "medicinal" and, in fact, "medic", that the term is descriptive. Such descriptive significance is exemplified by the registrant's composite mark disclosing a doctor or medic, both in its registration and in its advertising. The Court took judicial notice that it has many different connotations (JA 26, lines 1-4).

The term "MED" was held descriptive of the character or quality of a tampon in Personal Products Corporation v. Allen Laboratories, Inc., 141 F 2d 702, 61 USPQ 187 (CCPA, 1944).

"MEDIC ALERT" with design was held not registrable as an identification tag by the Trade-Mark Trial and Appeal Board of the Patent Office in In re Medic Alert Company, 120 USPQ 464 (1959).

"MEDICO PEDIC" used on footwear was referred to in Scholl Manufacturing Company, Inc. v. Schiff Company, supra.

The use of the term on various items in smoking pipes and filters and other uses are commonly known.

Hence, the use of a word such as "medic" having a medical connotation upon an additive for the purpose of alleviating lubricating oil ailments is not of startling novelty. It was error to ascribe overwhelming significance to the use of this common term with substantial disregard of the remainder of the mark.

V.

There Is No Reasonable Likelihood of Confusion As a Result of Concurrent Usage of the Composite Marks.

Purchasers of lubricating oil additives are assumed to be of average intelligence and to exercise reasonable care in purchasing an additive to place in their automobile lubricating systems. Assuming that the purchaser has been familiar with the trademark of the registrant, such purchaser is likely to remember the trademark as a whole, including the unusual caricature of a doctor in uniform holding aloft that which he prescribes, a can of the registrant's product, on a red background, and above which appears in yellow letters AUTO-MEDIC. Having seen this composite trademark, such average purchaser, exercising ordinary care, is not likely to believe, when he sees a product bearing MOTOR-MEDIC in slanting block letters, that it is of the same origin. This is especially true in view of the well-known fact that many competitive products are merchandised at service stations.

CONCLUSION

The Patent Office and the District Court erred in disregarding the entire trademark of the registrant and viewing the issue as solely a comparison of the word portions of the marks.

Viewed in their entireties, the mark sought to be registered and the composite mark of the registration are not so similar as to be likely to cause confusion or to cause mistake or to deceive.

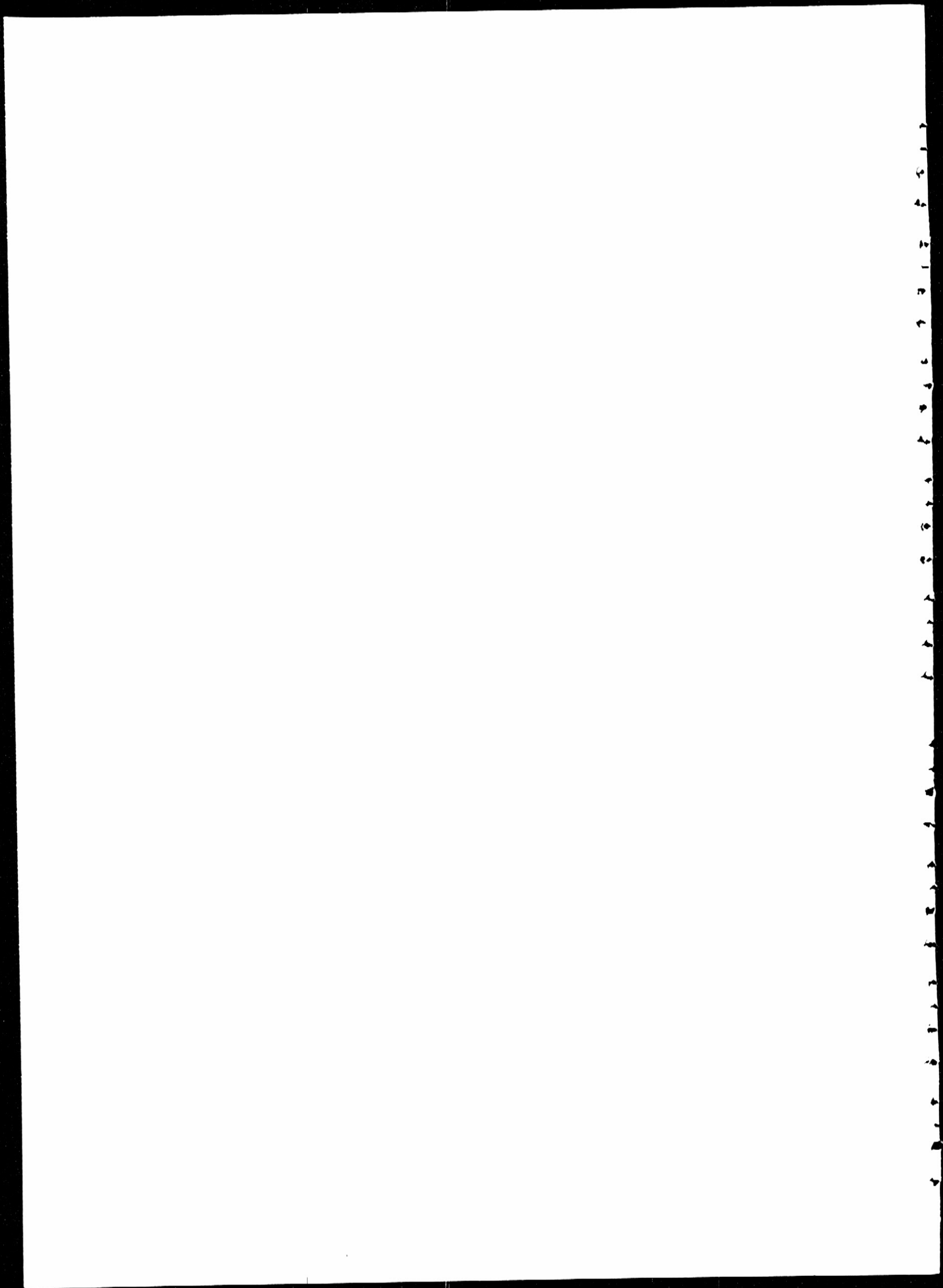
Respectfully submitted,

A. YATES DOWELL

A. YATES DOWELL, JR.

1345 Pennsylvania Ave., N. W.
Washington, D. C.

Attorneys for Appellant.



(i)

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JOINT APPENDIX

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

RADIATOR SPECIALTY COMPANY
1400 West Independence Blvd.
Charlotte 8, North Carolina

Plaintiff

v.

DAVID L. LADD
Commissioner of Patents
Washington 25, D. C.

Defendant

Civil Action No. 1278-62

RELEVANT DOCKET ENTRIES

<u>Date</u>	<u>Proceedings</u>
April 19, 1962	Complaint
June 5, 1962	Answer
June 5, 1963	Trial
June 5, 1963	Oral Decision
June 28, 1963	Memorandum Opinion
June 28, 1963	Judgment
July 29, 1963	Notice of Appeal

[Filed April 19, 1962]

COMPLAINT
[FOR REGISTRATION OF TRADE-MARK]

To the Honorable Judges of the United States District Court for the District of Columbia

1. Plaintiff, Radiator Specialty Company, is a corporation organized and existing under the laws of North Carolina and having its principal place of business at 1400 West Independence Boulevard, Charlotte, North Carolina.

2. Defendant, David L. Ladd, is the Commissioner of Patents of the United States, a legal resident of the District of Columbia, and is sued in his official capacity.

3. This complaint is filed in accordance with the trade-mark laws of the United States 15 USC (as amended) 1071 and 35 USC Sec. 145.

4. On September 24, 1958 plaintiff, acting in accordance with the trade-mark laws of the United States, 15 USC Sec. 1051, applied to the Commissioner of Patents for registration of the trade-mark MOTOR-MEDIC and complied with the provisions of law applicable to applications for registration.

5. On March 23, 1961 the Patent Office Examiner, acting on behalf of the Commissioner of Patents, finally refused to allow plaintiff's application for registration [SN 59,489].

6. Plaintiff, in accordance with law, appealed to the Trade-Mark Trial and Appeal Board on May 18, 1961 but the Trade-Mark Trial and Appeal Board in its decision of February 20, 1962 sustained the Examiner in his refusal of registration of the trade-mark.

7. Refusal of registration by the Examiner and the Trade-Mark Trial and Appeal Board was incorrect and not in accordance with law.

8. Plaintiff's application is in accordance with law and the Commissioner of Patents should be authorized to issue the trade-mark registration sought in the application.

9. No appeal has been taken to the United States Court of Customs and Patent Appeals from the decision of the Trade-Mark Trial and Appeal Board.

10. Plaintiff makes proffert of a copy of the aforesaid application and of the papers in the file thereof.

WHEREFORE, plaintiff prays for judgment that the Commissioner of Patents be authorized to grant the registration of the trade-mark sought in the aforesaid application and for such other and further relief as may be just and equitable.

/s/ A. Yates Dowell, Jr.
A. Yates Dowell
1345 Pa. Ave., N.W.
Washington 4, D. C.
Attorneys for Plaintiff

April 19, 1962

[Filed June 5, 1962]

ANSWER TO COMPLAINT

To the Honorable the Judges of the United States District Court for the District of Columbia

1. The defendant admits the allegations of paragraph 1 of the complaint.

2. The defendant admits that he is the Commissioner of Patents of the United States and is sued in his official capacity. The defendant denies that he is a legal resident of the District of Columbia. The defendant states that he is an official resident of the District of Columbia.

3. The defendant admits the allegations of paragraph 3 of the complaint.

4. The defendant admits that on September 24, 1958, the plaintiff applied to the Commissioner of Patents for registration of the trademark MOTOR-MEDIC. Otherwise, however, the defendant denies the allegations of paragraph 4 of the complaint.

5, 6. The defendant admits the allegations of paragraphs 5 and 6 of the complaint.

7, 8. The defendant denies the allegations of paragraphs 7 and 8 of the complaint.

9, 10. The defendant admits the allegations of paragraphs 9 and 10 of the complaint.

FURTHER ANSWERING, the defendant asserts that the plaintiff is not entitled to the trademark registration for which it has made application, for the reasons given and in view of the prior registration cited in the Examiner's statement and the decision of the Trademark Trial and Appeal Board in said application. Profert hereby is made of copies of the said statement, decision and registration.

Respectfully submitted,

/s/ C. W. Moore
Solicitor, U. S. Patent Office
Attorney for Defendant

[Certificate of Service]

TRANSCRIPT OF PROCEEDINGS

1

Washington, D. C.
Wednesday, June 5, 1963

The above-entitled matter came on for trial at 10:00 a.m. before the HONORABLE JOSEPH R. JACKSON, Senior Judge, United States District Court.

APPEARANCES:

On behalf of the plaintiff:	A. YATES DOWELL, ESQ. A. YATES DOWELL, JR., ESQ.
On behalf of the defendant:	CLARENCE W. MOORE, ESQ. Solicitor, United States Patent Office.

* * * * *

PROCEEDINGS

THE COURT: Call the case, Mr. Clerk.

THE DEPUTY CLERK: Radiator Specialty Company versus Ladd.

THE COURT: Are the parties ready?

MR. DOWELL: Ready, Your Honor.

MR. MOORE: Ready, Your Honor.

If the Court please, I will hand up in the traditional manner the Patent Office booklet, and if counsel for the plaintiff is agreeable and Your Honor is agreeable, I will offer this now out of turn as defendant's exhibit number 1.

THE COURT: That is the usual practice.

It may be received out of turn as defendant's exhibit number 1.

THE DEPUTY CLERK: Defendant's Exhibit Number 1.

(Defendant's Exhibit No. 1 was received in evidence.)

THE COURT: Have you a certified copy of the Patent Office proceedings?

MR. DOWELL: I have a certified copy of the file, Your Honor.

THE COURT: It may be received as plaintiff's exhibit number 1.

THE DEPUTY CLERK: Plaintiff's Exhibit Number 1.

(Plaintiff's Exhibit No. 1 was received in evidence.)

4 MR. DOWELL: If the Court please, I have had the Clerk mark the several exhibits we propose to introduce in order to save time.

THE COURT: Are you going to have any objection to those?

MR. MOORE: I haven't seen them before, Your Honor. I may well have objections.

THE COURT: Well, during the course of the trial you may do this. Now you may tell me what it is all about, please.

MR. DOWELL: I just had him put the numbers on for identification.

THE COURT: All that may be done during the course of the trial as usual.

MR. DOWELL: If the Court please, this is an application --

THE COURT: Why don't you get up to the lectern here? That is what it is for.

MR. DOWELL: This is an application seeking registration of the trade-mark Motor-Medic, M-o-t-o-r M-e-d-i-c. It is exemplified by the word Motor-Medic, as indicated, and the refusal is based upon trade-mark registration 651646, which discloses a background colored to red and the caricature of a doctor or medic, a can with a band around the top and the bottom and a light background, and the words Auto-Medic across the top of the design.

5 The goods of plaintiff are oil additives for internal combustion engines designed to stop oil burning and exhaust smoking, for reducing noise, for saving gas, and for generally improving performance, as stated on the label of the container in which the product is carried.

We are, of course, here to have this Court determine the question of whether or not there is confusing similarity between the proposed trade-mark for which application for registration is sought and this trade-mark registration 651,646.

THE COURT: I don't see a photostat of the application in here; your application for registration. Where is it? I don't find it in this certified copy. I would like to see it. Is it in your exhibit?

MR. MOORE: No, Your Honor, it is not.

THE COURT: I don't see it here. Possibly I may have overlooked it.

MR. MOORE: I would think it would be the first paper in the certified copy, Your Honor.

THE COURT: I may have turned over two pages.

MR. MOORE: The bottom paper, Your Honor?

THE COURT: Here is the declaration in the form of an affidavit by Herman Blumenthal. Oh, yes, I have it. I have it here. I turned over two sheets. You may proceed, Mr. Dowell.

6 MR. DOWELL: If the Court please, we propose to introduce evidence to the effect, that there is no likelihood of confusion or no confusing the mark of applicant for registration, Radiator Specialty Company,

having been in use for five years, since September of 1958, and the application filed and the specimen submitted which was for Auto-Medic, which prescribes friction-proofing; and the word "prescribes" is left off.

I would like the Court to take a look, if it will, please, to this exhibit 5.

THE COURT: I know, what you are seeking to have registered is --

MR. DOWELL: That is a specimen that was in the file of the Patent Office.

THE COURT: What you are seeking to have registered is two words, Motor-Medic, hyphenated.

MR. DOWELL: Two words.

THE COURT: All right, let's stick to that.

MR. DOWELL: The reason I mentioned this is because of the fact it was not considered a trade-mark independently but a composite mark consisting of all these elements, including a medic.

Now, the Trade-Mark Trial and Appeal Board issued --

7 THE COURT: I still don't find an application. All I see here is this, which is your sought for trade-mark for registration, and this (indicating). Where is the application? Where is the application? I want to see to what use.

MR. DOWELL: I thought it was there. I am sorry.

THE COURT: I don't see it.

MR. DOWELL: We requested a certified copy.

THE COURT: Well, they only certify what you ask for, don't they? I should imagine it would be the very first thing.

MR. MOORE: The original indicates the certified copy was made of page 1, and that is the first page of the application. Page 2 is the second page.

THE COURT: Well, page 1 is merely the certification. Page 2 says: "Attached is check No. 3204 in the amount of \$50.00 to cover the following filing fees." The next is a power of attorney, and the next is a declaration. It doesn't state anything about the use to which this is put. The next is a picture of the term as used, the next is just the word itself,

and then we have "Upon examination, registration is refused . . . "

MR. MOORE: Your Honor, don't you find a middle paragraph in the page entitled "Statement" which mentions oil additives for internal combustion engines?

THE COURT: Wait until I see.

8 MR. MOORE: If I may approach the bench I will show it to you, Your Honor.

THE COURT: I wish you would.

MR. MOORE: Here is the statement which I presume you will call the declaration (indicating).

THE COURT: Well, I don't see it here.

MR. MOORE: It is probably this page, isn't it?

THE COURT: No.

MR. MOORE: Here is the statement. That is page 1. Here it is.

THE COURT: I guess I turned too many pages over. All right.

You may proceed, Mr. Dowell. Excuse me for interrupting.

MR. DOWELL: I think perhaps the Court misunderstood what I was saying a moment ago.

THE COURT: This is an oil additive for internal combustion engines.

MR. DOWELL: That is correct. The goods are the same. I think probably the Court misunderstood me. This was a specimen from the registration that I was calling attention to.

THE COURT: I see.

MR. DOWELL: And I was calling attention to the fact that the registration lacked the word "prescribes". Auto-Medic prescribes friction proofing.

9 We will introduce evidence to show that there is no confusion and to show that the word "medic" is a common word which means it is a generic term in the public domain. We are going to show evidence to that effect, and that it means to relieve, improve or correct a condition.

Now, "Auto", of course, we recognize as a word that has five columns in the 1963 New Webster's International Dictionary.

We would like to take these witnesses, if the Court please, a little bit out of order because we have some men here who are in business in the city, and we would like --

THE COURT: You may put them on in any order that pleases you.

MR. MOORE: If the Court please, according to plaintiff's trial brief, the purpose of this hearing is to have the Court determine whether or not plaintiff is entitled to register its mark "Motor-Medic". It has been added here that the purpose of this hearing is to have the Court determine whether it is confusing similarity between that mark and the registered mark "Auto-Medic". We suggest that in no proper sense is this hearing for that purpose. The purpose of this hearing, we suggest, is to have the Court determine whether there is reversible error in the decisions of the tribunals of the Patent Office refusing registration.

10 THE COURT: I suppose the same presumption applies here as it does in patents.

MR. MOORE: Yes, sir, there is a presumptive correctness that attaches in a trade-mark case to the same extent it attaches in a patent case.

Your Honor has undoubtedly had his attention called to a case in this Circuit entitled Esso Standard Oil Company versus Sun Oil Company, which is reported at 97 U.S. App. D.C. 154. That has been regularly cited, I know, in patent cases, but it is in fact a trade-mark case. It is a trade-mark case where the question of confusing similarity was involved.

That case raised, the Court itself said, questions concerning the nature and scope of District Court's power to reject findings of the Patent Office in trade-mark cases. In resolving those questions the Circuit Court specifically stated, that the finding of fact of the Patent Office as to confusing similarity of marks must be accepted as controlling unless the contrary is established by evidence which in character and amount carries thorough conviction. The Court added --

THE COURT: Well, it is the same principle that is applied to all patents?

MR. MOORE: Yes.

THE COURT: To patents as well as to trade-marks?

MR. MOORE: Yes.

11 THE COURT: The Court is cognizant of that.

MR. MOORE: The Court added by way of emphasis, that the finding must be accepted if it is consistent with the evidence in view of the expertise of the Patent Office Tribunal.

THE COURT: And the only thing that would cause the Court really to reverse would be that the evidence shown by the plaintiff convinced the Court that the decision of the Patent Office was wrong; clear error.

MR. MOORE: Right, Your Honor.

THE COURT: That is right, I understand all that.

MR. MOORE: If I might just read two short sentences of that opinion.

"Where the decision of the Patent Office has a substantial basis in fact, and where the new evidence offered to the trial court is not sufficient to shift the balance, (i.e., is not enough to produce 'thorough conviction' to the contrary,) the Courts are simply not authorized to substitute their own views. For a judge to conclude that he himself would not be confused by two competing trade-marks -- and hence that the public would not be confused -- is beside the point: the question is whether the expert agency charged with responsibility in the matter has in view of all the evidence clearly erred in finding that the possibility of confusion exists."

12 Now there have been specific findings made by the Trade-Mark Trial and Appeal Board here. One finding is that the marks are applied to goods identical in kind. It has been admitted here this morning that the goods are the same.

The Trade-Mark Trial and Appeal Board also found that the marks have the same meaning. It additionally found that the marks create the same commercial impression.

And then it finally, as an ultimate finding, found there is confusing similarity.

THE COURT: Well, I suppose that counsel for the plaintiff intends to show that is wrong. Is that correct?

MR. DOWELL: That is correct.

MR. MOORE: The position of the Patent Office is that that is the burden, the heavy burden of the plaintiff.

THE COURT: You may proceed, Mr. Dowell.

MR. DOWELL: I call Mr. John Henry Parater.

MR. MOORE: If Your Honor please, I want to invoke the witness rule in this case.

THE COURT: Very well.

THE DEPUTY MARSHAL: All witnesses step forward. Anyone who is going to testify please step this way.

MR. DOWELL: We have an officer of the company here also. He should step forward.

THE COURT: Who is he?

MR. DOWELL: The vice-president of the company.

MR. MOORE: I have no objection to his staying.

13 THE COURT: He may stay.

Thereupon --

MR. JOHN HENRY PARATER

was called as a witness by and on behalf of the plaintiff and, having been first duly sworn, was examined and testified as follows:

DIRECT EXAMINATION

BY MR. DOWELL:

Q. Please state your full name, your address, your age and your business connection? A. My name is John Henry Parater. I am president of Phelps-Roberts Corporation at 1825 14th Street, Northwest. I am fifty-six years old.

Q. What is the business of your company? A. Our company is a wholesale distributor of automotive parts, accessories and related items.

Q. Give us something of your background, please? A. I have been in this business since 1923. I guess it has been almost from the

beginning of the business or thereabouts. I have seen the growth of the business. In those days there were practically no chemicals as such that we had to sell in the business and they, of course, came along as the business progressed through the years. I don't know how much further you would like me to go from the standpoint of experience and carrying it forward as far as our firm is concerned.

- 14 Q. What do you know about substances that are added to oils and lubricants and gasoline and the like? Do you sell those? A. We do. We distribute quite a broad variety of automotive chemicals. I don't propose to say that I am an expert on those products that go in the crank-case. I know generally the function of those products.

THE COURT: And the effect?

THE WITNESS: And the effect.

THE COURT: All right.

BY MR. DOWELL:

Q. State whether or not you are familiar with Motor-Medic?

A. Yes, sir, I sure am.

Q. Do you sell that product? A. We do, sir.

Q. How long have you been selling it? A. We have been selling it -- I will have to give you an estimated fair guess -- something about four years.

Q. Are those sales in substantial quantities or in very small quantities? A. I don't know just how you mean that.

Q. Large volume or small volume? A. I would not say it is large. I would say it is moderately large. Are you speaking now of your particular product of Motor-Medic?

15

Q. Motor-Medic. A. Mild volume.

Q. How about Auto-Medic?

MR. MOORE: I object, Your Honor, to this line of questioning.

THE COURT: Wait a minute. Are these two gentlemen going to be witnesses of yours?

MR. DOWELL: Yes, they are witnesses also. I am sorry. I didn't notice they came in.

THE COURT: Follow the Marshal, please.

BY MR. DOWELL:

Q. Do you sell other products of this line? A. Do we sell other products of similar nature?

Q. Yes, sir. A. I don't think we sell any other products that have the same chemical makeup as this product. We sell other crankcase additives, however.

Q. By crankcase, do you mean lubricating oils? A. Yes, you could term them lubricating oils. You could also term an additive as a solvent.

THE COURT: Something that you add to the ordinary oil, is that it, which goes into the crankcase?

THE WITNESS: That is correct.

16

THE COURT: All right.

THE WITNESS: And they do vary in their function, that is, certain products vary.

BY MR. DOWELL:

Q. Have you heard of the product Auto-Medic, Exhibit for Identification 6?

MR. MOORE: I object, Your Honor. The question here is as to the registerability of applicant's mark in view of the registration and not in view of a use in the market. This is not an opposition proceeding in which I represent the opposer. I represent exclusively the Commissioner of Patents.

THE COURT: What is your purpose?

MR. DOWELL: Well, I propose to ask him if there is any --

THE COURT: Are you trying to show there is no danger of confusion of origin? Is that it?

MR. DOWELL: That is correct.

THE COURT: Well, I will let it go in on that basis.

BY MR. DOWELL:

Q. Have you ever heard of Auto-Medic? A. Well, I have to be perfectly honest with you. The name did not ring a bell to me when I first heard the name.

17 Q. You testified you have been selling Motor-Medic for approximately four years? A. That is correct.

Q. Have you ever known of an instance of confusion? A. To my knowledge, I do not.

I might elaborate on that, if the Court permits. Up until this thing came about I have not had one of my ten salesmen yet come to me and say anything about this particular product.

THE COURT: You didn't know anything about the Auto-Medic, is that it?

THE WITNESS: No, sir.

MR. DOWELL: That is all.

THE COURT: Have you any cross-examination?

MR. MOORE: No cross-examination, Your Honor.

THE COURT: You may be excused. You may remain in the courtroom or go, whichever you see fit.

Call your next witness.

MR. DOWELL: Jack Simpson.

THE DEPUTY MARSHAL: Mr. Simpson couldn't be here. This is a replacement for him, Mr. Ginnakis.

MR. DOWELL: What is that name?

THE DEPUTY MARSHAL: Mr. Z. S. Giannakis.

Thereupon --

18 MR. Z. STEVE GIANNAKIS

was called as a witness by and on behalf of the plaintiff and, having been first duly sworn, was examined and testified as follows:

DIRECT EXAMINATION

BY MR. DOWELL:

Q. Mr. Giannakis, will you state your name again? A. Z. Steve Giannakis, G-i-a-n-n-a-k-i-s.

Q. Mr. Giannakis, state your residence. A. 5107 Crittenden Street.

Q. And your business? A. Well, I am the assistant manager of Columbia Garage and double in bookkeeping.

Q. How long have you been in your present position? A. Two years.

THE COURT: Is that a service station?

THE WITNESS: No, it is a garage. We specialize in taxicab work, auto repairing.

BY MR. DOWELL:

Q. What was your experience before that? A. I drove a taxi.

Q. How long? A. Twenty-two years.

Q. Are you familiar with preparations that your company sells, or materials or products that your company sells?

19 THE COURT: Are you selling anything now?

THE WITNESS: Sir?

THE COURT: Are you selling anything now?

THE WITNESS: Personally?

THE COURT: In your present occupation are you selling additives?

THE WITNESS: Well my job is I help the service manager when he is not there and I also keep the books for the company.

THE COURT: I thought you told me it was not a service station?

THE WITNESS: It is not a service station.

THE COURT: What is it?

THE WITNESS: A garage.

THE COURT: What do you do, just store cars?

THE WITNESS: Auto repairs.

THE COURT: That is what I mean when I say service.

THE WITNESS: Oh, I am sorry.

BY MR. DOWELL:

Q. If you handle any products, state what they are, please.

A. What sort of products do you mean now?

Q. Does your company sell products? A. Yes.

20 Q. And what products does it sell? Other than service, does it sell products? A. Well, we sell parts.

Q. Do you sell preparations that go into the car?

THE COURT: Do you sell lubricating preparations?

THE WITNESS: Yes, we do. We sell oil and additives.

BY MR. DOWELL:

Q. Do you sell Motor-Medic? A. Yes, we do.

Q. Do you sell Auto-Medic? A. Yes, occasionally. Not very often. We specialize more on Motor-Medic.

Q. How long have you been selling these two products? A. Well, like I say, I have been there two years. We had Motor-Medic when I first got there.

Q. Did you know of these before you went there? A. Frankly, no, sir.

Q. You did not? A. No.

Q. Then your knowledge of them is limited to two years? A. Two years.

Q. This is the first time I have faced you, is it not? A. That is correct.

Q. State whether or not you have ever known of an instance of confusion between Motor-Medic and Auto-Medic? A. I never have.

21 MR. DOWELL: That is all.

THE COURT: Have you any cross-examination?

MR. MOORE: Just one or two questions, Your Honor.

CROSS EXAMINATION

BY MR. MOORE:

Q. Is this garage or service station run as a retail organization?
A. Yes, it is.

Q. Do you have Motor-Medic and Auto-Medic on the shelves?
A. We specialize in Motor-Medic. We don't have Auto-Medic on the shelf, to my knowledge, at the moment.

Q. Is Motor-Medic on the shelves? A. Actually at the moment we have a separate corporation that sells our parts and we actually in the garage don't stock the Motor-Medic on the shelf. We get it from them as we need it.

MR. MOORE: No further questions.

REDIRECT EXAMINATION

BY MR. DOWELL:

Q. Do they also stock Auto-Medic? A. Frankly, I couldn't say.
I am not positive.

Q. But you have seen the product, Auto-Medic? A. Oh, yes.

22 MR. DOWELL: That is all.

THE COURT: Are you through with the witness?

MR. MOORE: Yes, Your Honor.

THE COURT: Call your next witness.

MR. DOWELL: Mr. Younes.

Thereupon --

MR. EDWARD YOUNES

was called as a witness by and on behalf of the plaintiff and, having been first duly sworn, was examined and testified as follows:

DIRECT EXAMINATION

BY MR. DOWELL:

Q. Please state your name, residence, your age and occupation?

A. Edward Younes, 11000 Eastcrest Drive, Silver Spring, Maryland. I am forty-five and I am the general manager, National Auto Service Company, Washington.

Q. What is the National Auto Service Company? A. Automotive parts wholesaler.

Q. How long have you been with your present connection?

A. With this firm five years.

Q. What was your experience before that? A. I worked for

L. S. Julian Automobile Parts Wholesalers for twenty years.

23 Q. Where is L. S. Julian located? A. They are now out of business.

Q. How long have they been out of business? A. Five years.

Q. In other words, after they closed you went with your present connection? A. They liquidated.

Q. They liquidated. Do you know Radiator Specialty Company, the applicant for trade-mark registration before this Court? A. Do I know about it, do you say?

Q. Do you know Radiator Specialty Company's personnel or salesmen or anything about it? A. Yes, I do.

Q. What kind of a corporation is it so far as its activity is concerned? A. We have enjoyed an excellent relationship with this firm and the people working for them.

Q. Are you familiar with the products that they handle or some of the products? A. Most of them. They have quite a few products. Most of them.

Q. Will you mention some of them? A. Well the products that are now there, the Motor-Medic, Trans-Medic, Transeal, Liquid Wrench; and a few other products would be handled.

24 Q. How about Solder Seal? A. Solder Seal.

Q. Are you familiar with Wynn Company that merchandises Auto-Medic?

MR. MOORE: I make the same objection, Your Honor, to this line of questioning.

THE COURT: Oh, I will let it in. There is no jury here and, of course, the Court pays no attention to things that are irrelevant.

MR. DOWELL: Have you answered the question?

THE COURT: He is not offering it. I will let him talk about it, examine the witness concerning it.

THE WITNESS: I am familiar with Wynn's products. Of course, I am more familiar with Wynn's Friction Proofing Oil, which is more prominent than the product you just mentioned, Auto-Medic.

THE COURT: In other words, what the witness is testifying to appears to me to be totally irrelevant. I am very generous about letting things in but this is approaching the kitchen stove, I think. I don't think this is relevant at all, this type of examination. You may question him concerning the issues. Question him as to his knowledge of both Motor-Medic and Auto-Medic. That is what the issue here is about.

25 MR. DOWELL: I may question him about what, if the Court please?

THE COURT: The issue between Motor-Medic and Auto-Medic. That is what it is. According to the Patent Office, these are confusingly similar.

MR. DOWELL: If the Court please, that is what I was leading up to.

THE COURT: I don't see where the manufacturer of these other things has anything to do with this issue. What has the manufacturer to do with it? What does he know about the manufacturer?

MR. DOWELL: If the Court please, I may not use the proper language, but I am talking about two products on the market.

THE COURT: And those two products are Auto-Medic and Motor-Medic?

MR. DOWELL: Auto-Medic and Motor-Medic.

THE COURT: Go ahead.

MR. DOWELL: I would like to --

THE COURT: You asked something about the manufacturer. That doesn't make any difference, the manufacturer, does it?

MR. DOWELL: I appreciate that. I was purely thinking differently from what I was saying. I apologize.

THE COURT: You needn't. I am used to it in this type of a trial anyway.

26

BY MR. DOWELL:

Q. I all ask you, please, whether or not you have ever known of any instance of confusion between these two products? A. I will have to answer no, unless you want me to elaborate a little bit.

Q. I would ask you to explain your answer further. A. Well, we have five salesmen travelling the road.

THE COURT: Do you sell both?

THE WITNESS: No, sir, we don't.

THE COURT: How could you judge as to whether there is confusion or not if you don't sell both of them?

THE WITNESS: I was just about ready to explain that, Your Honor.

THE COURT: Go ahead.

THE WITNESS: We have five salesmen travelling, and if you are familiar with salesmen who are on commission basis, they are in every day complaining about competitive products or price and things of that nature. If they are on a commission basis they want to try to make every sale they can. We have handled Radiator Specialty Company products for a number of years, and particularly Motor-Medic, which is the issue before us. I haven't once from the time we have handled Motor-Medic and from the time that this Auto-Medic has been out ever received any complaints or any criticism from our salesmen who sell the
 27 product stating that they have had any confliction between their purchasers, which is the service station operator, garage or car dealer, any confusion between these two products; and that is how I base my decision.

THE COURT: I see.

BY MR. DOWELL:

Q. How do you explain any lack of confusion? A. I can't right-fully explain that. In what way do you mean? Maybe I don't understand the question.

THE COURT: I think he endeavored to show you why he thought there was no confusion. Now you ask him to explain the lack of confusion. I don't believe it is pertinent.

MR. DOWELL: All right, I will withdraw the question.

BY MR. DOWELL:

Q. Are both of these products sold through the same channels?

A. No, they are not. To my knowledge, they are not. I have several friends who sell Wynn's and the method of distribution of the Radiator Specialty Company is as a manufacturer they distribute through local jobbers and warehouses, whereas, Wynn's have individual salesmen in this product.

Q. I mean the retail. Are they sold through the same retail outlets? A. Yes, sir, as far as I know they are; through the service

28 stations and through the garages and through the people like Sears, Roebuck and Pep Boys, etc.

MR. DOWELL: Thank you. That is all.

CROSS EXAMINATION

BY MR. MOORE:

Q. You do not sell to automobile owners, do you? A. No.

Q. You sell to retailers who in turn sell to automobile owners?

A. We sell to the service station. He is not a retailer. He redistributes to the owner. Yes, he is a retailer.

Q. And that is true as to the sale of Motor-Medic? A. That is the product we sell; yes, sir.

Q. That is, the sales are first from you as a wholesaler to the retailer and then from the retailer to the automobile owner, say?

A. That is right.

MR. MOORE: That is all, Your Honor.

THE COURT: Are you through with the witness, Mr. Dowell?

MR. DOWELL: Yes, Your Honor.

THE COURT: You may be excused. Call your next witness.

29 MR. DOWELL: Mr. Horace Walker.

Thereupon --

MR. HORACE WALKER

was called as a witness by and on behalf of the plaintiff and, having been first duly sworn, was examined and testified as follows:

DIRECT EXAMINATION

BY MR. DOWELL:

Q. Please state your name, age, residence and business? A. My name is Horace Walker. I am sixty-one years old. I am a publisher and editor and I am executive vice-president Masthead Publishing Company, and our studios and offices are at 3432 Connecticut Avenue, Northwest, Washington 8, D.C.

Q. How long have you been in your present business? A. I have been in the public relations business practically all my life, but in the last fifteen years I have been devoting most of my time to associations. I was the executive director of the Retail Gasoline Dealers Association here and published a magazine for them in the automobile service field for the last fifteen years.

Q. Are you acquainted with Radiator Specialty Company, the applicant here? A. I am.

Q. Are you acquainted with Wynn's Company, who has a registration?

30 A. I am acquainted with the company; yes.

Q. Tell us what these companies do, if you please, or some of the things they do? A. They manufacture oil additives which are sold through service stations, garages, repair shops, body shops and any automotive service outlets.

Q. How do you know? A. Well, I have had an opportunity in the past fifteen years as being the editor and publisher of these magazines to visit these various outlets and to see the products actually displayed and, as a matter of fact, arranged for and assisted in publicizing the products and writing advertising for them.

Q. What is the latest issue of your magazine? A. This month, June.

Q. What is the reputation of Radiator Specialty Company? A. From the standpoint of the products, which is all, of course, I can say, it is considered one of the best in the business.

Q. Don't you advertise for these several companies? A. Yes, sir.

Q. From the viewpoint of your business relations, what would you say their reputation is? A. Very fine.

31 Q. I hand you a copy of the magazine, Today, the Automotive Service Station, June 1963. Are you familiar with this magazine? A. I should be. I produced it.

Q. When was this issued? A. It went into the mail yesterday.

Q. I refer you to page 20 of this magazine. Have you another copy with you, please? A. There is one back there (indicating).

MR. DOWELL: I want to show counsel page 20.

BY MR. DOWELL:

Q. I notice on page 20 that you have an illustration of a container with the words "Trans-Medic" across it. To what company does that relate? A. Radiator Specialty.

Q. And I notice a young lady with something in her lap in the right-hand column on the same page. To what company does that relate? A. This is Wynn's.

Q. Will you please let the Court take a look at that?

MR. MOORE: Are you offering that, Mr. Dowell?

MR. DOWELL: Not yet.

BY MR. DOWELL:

32 Q. I notice that says "Trans-Medic". What is Trans-Medic, if you know? A. Trans-Medic is an oil additive that you add to the transmission of the automobile to perfect or assist in the lubrication.

Q. What is Motor-Medic? A. It is the same thing only it applies -- It is the same principle only, may I say, the chemical analysis would be different as applies to an automobile engine.

Q. What is the material? You say it is applied to the engine; what part of the engine? A. It is put into the oil. It is an oil additive, in other words.

Q. This magazine is published by you? A. Yes, sir.

MR. DOWELL: We will offer that, please.

THE COURT: I don't see any relevancy of it but you may offer it.

MR. MOORE: I object. It proves nothing, Your Honor.

THE COURT: I know it doesn't. It is immaterial, but if he wants to offer it all right, let him. It may be received.

(Plaintiff's Exhibit No. 11 was received in evidence.)

33

BY MR. DOWELL:

Q. Then I ask you whether or not you have ever known any instance of confusion between Radiator Specialty's marks, Motor-Medic, Trans-Medic and other marks and any other marks of competitors? A. Not to my knowledge.

Q. And that includes Auto-Medic as well as Motor-Medic? A. Yes, sir. It might help the Court to understand that in my position I have been closely connected with the outlets or the points from which these materials are distributed to the consumer, the motorists, the service stations, et cetera; and particularly I have been interested in the additive or chemical phase of the automotive service because there are so many of them and they do so many things; and it is rather difficult to keep track of them actually from the practical standpoint; but I have had ample opportunity during the past fifteen years to observe them.

Q. And you have found no confusion? A. None whatsoever.

MR. DOWELL: That is all.

THE COURT: Have you any cross examination?

MR. MOORE: Yes, Your Honor.

CROSS EXAMINATION

BY MR. MOORE:

Q. You sell publicity, don't you, Mr. Walker? A. Yes, sir.

34

Q. You don't sell products? A. No, sir.

MR. MOORE: That is all.

THE COURT: Are you through with the witness?

MR. DOWELL: Yes, Your Honor.

THE COURT: You may be excused.

Call your next witness.

MR. DOWELL: Mr. Hoffman.

Thereupon --

MR. DAVID HOFFMAN

was called as a witness by and on behalf of the plaintiff and, having been first duly sworn, was examined and testified as follows:

DIRECT EXAMINATION

BY MR. DOWELL:

Q. Please state your name, age, residence and occupation? A. David Hoffman, age forty-seven, residence, Charlotte, North Carolina. I am the general sales manager of Radiator Specialty Company.

Q. How long have you been the general sales manager? A. Since 1955.

Q. What was your work prior to that? A. I had been the assistant sales manager of Radiator Specialty Company from 1948 to 1955.

Q. In other words, you have been with Radiator Specialty for about fifteen years? A. Yes, sir.

Q. First in the position as assistant sales manager and then as general sales manager? A. Yes, sir.

Q. What was your training before this fifteen years you mentioned? A. Prior to that I had been in the men's clothing manufacturing business primarily in sales and also in general management.

Q. You were in the service? A. Yes, sir, from 1941 to 1946.

Q. What did you do in the service? A. Well, I went in as a private in the Medical Corps as a company aid man, stretcher-bearer, went to Quartermaster Candidate School in '42 when they needed officers so badly, and then I was mustered out in '46 as a captain in the Quartermaster Corps.

Q. You said you were a stretcher-bearer? A. Yes, sir.

Q. Did they call you a "medic"? A. Yes, this was the term used for anyone in the Medical Corps.

Q. Have you had the occasion to examine the word "medic" from a dictionary viewpoint? A. Not very deeply.

THE COURT: I think the Court can take judicial notice that it is used very generally and in many different connotations.

MR. DOWELL: Thank you.

MR. MOORE: I may say, Your Honor, I am perfectly willing to consult any dictionary for disposition of the case.

THE COURT: I even have a fact here that a medico is known as a medic.

BY MR. DOWELL:

Q. Now, tell us something of your duties when you were assistant sales manager and since you have been general sales manager? A. Well, as assistant sales manager my primary duty was and that in which I spent most of the time was travelling throughout the country calling on our key accounts, mainly automotive, recruiting salesmen, training salesmen, observing competitive conditions, working on programs and promotions.

Now since I have been general sales manager that is also a part, an important part of my duty. I don't travel as much and I am more involved
37 with personnel than I was as strictly assistant sales manager.

Q. What products does your company sell? A. We make and sell a line of chemical and rubber products for the automotive service industry, for the plumbing service industry, for hardware and for the mill supply industry in general.

Q. Do you manufacture traffic safety? A. Yes, we manufacture a line of rubber and plastic traffic control devices. The products you see on the streets of Washington are mainly of our manufacture.

Q. In other words, you manufacture a line of products that are quite diversified, including packaged products? A. Yes, sir.

Q. Which the customer can buy? A. The packaged chemicals are our major line.

THE COURT: You do manufacture Motor-Medic, don't you?

THE WITNESS: Yes, sir.

THE COURT: All right, go ahead from there.

BY MR. DOWELL:

Q. How are these products marketed? How does the customer get them? A. We sell our products to the automotive distributor or
38 jobber. The names are synonymous. They in turn resell them to the dealer level, which would include service stations, garages, car dealers, auto supply stores, fleet operators. This would generally cover the entire range.

Q. What is the Motor-Medic product intended to do? A. Well, Motor-Medic is an oil stabilizer. The technical name that the oil companies attach to it is "viscosity index improver". It is intended to stabilize the oil so that it does not thin out excessively at high temperatures, high operating temperatures, and at the same time it does not thicken the oil when the oil is cold. And, of course, it does exactly what we claim on the package, it stops the burning of oil, which is caused by a thin oil getting past the piston rings into the combustion chamber where it is burned up with the gas. And this is what creates that blue cloud of smoke you see coming out the exhaust of many cars. It is oil burning in the combustion chamber. Now Auto-Medic is intended to reduce or prevent that.

Q. How long has your company been using Motor-Medic? A. We have had it on the market since September of 1958.

Q. How did you happen to choose that name? A. Well --

THE COURT: Or do you know?

THE WITNESS: Sir, yes. I took part in it.

39 THE COURT: Well, tell us.

THE WITNESS: Well, choosing a name --

THE COURT: How did you do it?

THE WITNESS: Five or six of us in the sales department closeted ourselves in a room and covered blackboards and sheets of paper with recommended names and by a process of elimination we arrived at the Motor-Medic as the name that best described what the product was intended to do to the average consumer.

THE COURT: I see.

BY MR. DOWELL:

Q. To whom do you sell this product? A. We sell it to --

THE COURT: He sells it to the jobbers who in turn sells it to the dealers who in turn sells it to the consumer. That is what he said.

BY MR. DOWELL:

Q. Well, it is the extent that I am interested in. A. Sir?

Q. To what extent is this product sold so far as geography is concerned? A. It is sold nation-wide, in certainly forty-nine of the fifty states, Canada and throughout the world.

Q. How many service stations and jobbers do you have? Can you estimate that? A. It varies, but I believe six-thousand distributors would
40 be a fairly accurate account, and those six-thousand distributors serve somewhere in the neighborhood of two-hundred thousand service stations.

Q. Can you tell us something of the volume of your advertising and sales since you have had this item out? A. Yes, sir. I don't carry them around in my head but I wrote them down on a sheet of paper here.

Q. Where did you get this information? A. These figures were taken from our sales records which are kept in my office. Statistics --

Q. Under your control? A. Yes, sir.

MR. DOWELL: May we interrupt this witness at this time to call another witness, Your Honor?

THE COURT: Yes.

Mr. Please step aside until the other witness has finished.

Thereupon --

MR. FRANK MARZULLO

was called as a witness by and on behalf of the plaintiff and, having been first duly sworn, was examined and testified as follows:

DIRECT EXAMINATION

BY MR. DOWELL:

41 Q. Please state your name. A. Frank Marzullo.

Q. How do you spell that, please? A. M-a-r-z-u-l-l-o.

Q. Your age, residence and business. A. I am thirty-three. I live at 1352 Madison Street, Northwest. Auto repair. Service station and auto repair combined.

Q. How long have you been in your present business? A. Self-employed for ten years.

Q. What was your experience before that? A. Auto machanic for five years.

Q. Where? A. Well, with Grady Motors, Mann Oldsmobile, Kay Ford.

Q. Around the metropolitan area; is that correct? A. That is right.

Q. Are you familiar with -- Strike that, please. Tell us whether or not you sell supplies such as oil additives? A. Yes.

Q. Are you familiar with Motor-Medic? A. Yes.

Q. And Auto-Medic? A. Yes.

Q. Have you ever known of any confusion in the minds of anyone that approached you? In other words, have you ever known of any confusion in these products? A. Not myself but a couple of days ago
42 there was a confusion with a customer.

Q. What was that? A. A customer came in and asked for a can of Wynn's Motor-Medic and we told him we didn't have Wynn's Motor-Medic. We told him we had different brands. And this was an employee of mine that told me that this morning.

Q. When I called you on the phone yesterday you told me you had never heard of any confusion; is that correct? A. I haven't myself; no.

MR. DOWELL: That is all.

MR. MOORE: No questions, Your Honor.

THE COURT: You may step down.

The former witness may resume the stand.

THE DEPUTY MARSHAL: This man may be excused permanently,
Your Honor?

THE COURT: He may be excused, yes.

MR. DOWELL: Thank you very much.

Thereupon --

MR. DAVID HOFFMAN,

a witness called by the plaintiff, resumed the stand and, having been previously duly sworn, testified further as follows:

DIRECT EXAMINATION (Resumed)

BY MR. DOWELL:

43 Q. We were asking you about the advertising and sales, I believe?

A. Yes, sir.

Q. Would you give us those figures? A. Well, from the time that we started through 1962, which would be a total of four and a quarter years, our sales of Motor-Medic amounted to \$2,486,000.00. In units that was approximately 6,660,000 units, packages, bottles or cans.

During that four and a quarter years we spent on advertising a total of \$604,000.00. Now that can be broken down. The advertising can be broken down into media which would include newspapers, radio, television and trade publications. On this media it was \$378,000.00. On display racks, which are a very important part of our promotional efforts -- the type of rack you see in service stations on which our name is shown, the product name and the cans are displayed for impulse buying on the part of the motorist -- we spent \$145,000.00 on that. And then on mailings, posters, envelope stuffers --

THE COURT: None of this has anything to do with the issue here. You may have \$40,000,000.00 worth of sales. What has that to do with the registerability of the mark you seek to have registered?

MR. DOWELL: If the Court please, I am about to ask the witness
44 over what area this was done and --

THE COURT: That is perfectly proper, but the amount of the sales and the amount of money doesn't make a bit of difference. You may ask him about the areas and with respect to anything that may be pertinent to the issue here in that area.

BY MR. DOWELL:

Q. Over what area were these sales? A. Nation-wide; coast to coast and border to border.

Q. I believe you said you visited the various states? A. Well, during the time I have been with the company I have worked in forty of the forty-eight Continental United States.

Q. Are you familiar with the Wynn Oil Company? A. Yes, sir.
Very much so.

Q. How long have you known them? A. Ever since I have been with Radiator Specialty Company and in this automotive service business, which is almost fifteen years.

Q. When did it first come to your attention that Wynn claimed any rights in the trade-mark "Auto-Medic"?

MR. MOORE: Objection, Your Honor.

THE COURT: That is a registered mark, isn't it, the Wynn mark?

45 MR. DOWELL: That is correct.

THE COURT: Well, it is registered. They have a right to it. Why do you ask him when they claimed the right to it?

MR. DOWELL: I want to show there is no deliberate copying of the mark. Isn't that pertinent? I thought it was.

THE COURT: Reframe your question then. Ask him whether or not they knew the Wynn mark was in effect. Ask him that.

MR. DOWELL: I am afraid I can't jump two questions ahead when I am leading up to something.

THE COURT: Go ahead. Go at it at your own pace then.

BY MR. DOWELL:

Q. Tell us what you know of the Wynn mark, Auto-Medic? And tell us whether or not there has been any contest in the field, any confusion or conflict?

THE COURT: Do you know the Wynn product, Auto-Medic?

THE WITNESS: Yes, sir, I do.

THE COURT: All right, you know your own?

THE WITNESS: Yes, sir.

THE COURT: How did you come to adopt the name "Motor-Medic"? Did you know at the time there was a product called "Auto-Medic"?

46 THE WITNESS: No, sir, we did not. The first we learned of Auto-Medic as a registered mark was when the Trade-mark Section of the Patent Office cited it as a basis for refusing the registration of Motor-Medic.

THE COURT: Well, that would remove any likelihood of stealing it or appropriating somebody's mark or getting as close to it as you could.

In other words, you done it in good faith?

THE WITNESS: Definitely.

Now, did you want me to go on, sir?

BY MR. DOWELL:

Q. I want you to explain what you know about the situation; yes.

A. Well, at that point, when we first learned of the existence of the registration of Auto-Medic, we started to dig into it and find out why we could have missed up on knowing about it. We learned that at that time it was not attached to any product but that it was descriptive of the cartoon character of the doctor which they called Auto-Medic.

MR. MOORE: Your Honor, I object to this as a collateral attack on the validity of the registration here.

THE COURT: The Court will pay no attention to it. That isn't relevant or pertinent here at all.

BY MR. DOWELL:

Q. What happened after that? A. Well, in late 1960 we saw the
47 appearance of a product called Auto-Medic on the market in Canada and in the United States. It first appeared, to the best of our knowledge, in Canada.

THE COURT: Was it competitive to your own product, Motor-Medic?

THE WITNESS: Yes, sir.

THE COURT: I see.

THE WITNESS: This was Auto-Medic put out by Wynn Oil Company, and our first knowledge of it came about in late 1960 and early '61. Since that time we have been competing with it, that is Motor-Medic has been competing with Auto-Medic all over the country and in Canada.

BY MR. DOWELL:

Q. Is it customary for your company to learn of competitive products? A. Yes, sir.

THE COURT: When they are brought to your attention, naturally, isn't that it? When they are brought to your attention you know about them, but not prior to that. If there is nothing to appeal to any of your senses you don't know anything about it, do you?

THE WITNESS: No, sir.

THE COURT: When you learn about it you know it?

48 THE WITNESS: We learn about competitive products very quickly.

THE COURT: Of course you do. But how do you do it, because you see it being sold or advertised?

THE WITNESS: Yes, our salesmen report it in a matter of days or weeks when it is on the market. This is part of their job. They give us a constant feed back of information from the field which is vital to our program.

THE COURT: The Court is well aware of that.

Are you going to have any further witnesses, Mr. Dowell?

MR. DOWELL: No, sir.

THE COURT: This is the usual time for the morning recess but go ahead, we will work right through the recess time.

BY MR. DOWELL:

Q. You stated that you had approximately six-thousand jobbers who sold to some two-hundred thousand service stations throughout the forty-nine states? A. Yes, sir.

Q. I presume the state in which you don't sell any is Alaska, is that correct? A. Correct.

Q. Have you received any reports of instances of confusion as a result of your use of the term "Motor-Medic" as a trade-mark and the competitive product "Auto-Medic"? A. Not a single one.

49 Q. Do you know of anyone who has heard of any confusion in your company? In other words, you have covered everything that you have heard relative to other people too, I presume? A. To the best of my knowledge, no one else has either.

Q. Have you made any special inquiry to determine whether there have been any instances of confusion or conflict? A. Yes, sir, we did. We instructed our salesmen to investigate a representative sampling of the trade, dealers in their territories, and to report to us.

Q. In what territories? A. All over the country. And the results of that investigation, based on our salesmen's reports of interviews in

the field, was that they ran across no confusion. As a matter of fact, during the course of that investigation our salesmen were given affidavits, sworn statements, to the effect that people who were handling both products had not had any confusion either to themselves or among their customers.

MR. DOWELL: If the court please, we overlooked the fact we have the vice-president of the company here.

THE COURT: Is he going to be a witness?

MR. DOWELL: I think so.

THE COURT: Is he going to take the stand.

MR. DOWELL: Yes, sir.

50 THE COURT: Very well then, the Court will take its usual morning recess until 11:35.

(Whereupon, at 11:20 a.m. the Court recessed and reconvened at 11:40 a.m.)

THE COURT: The witness will resume the stand.

You may proceed.

Are you through with this witness?

MR. DOWELL: Not quite, Your Honor.

THE COURT: All right, no hurry. Go ahead.

BY MR. DOWELL:

Q. You stated, Mr. Hoffman, that you have salesmen and the like distributed throughout the country. What products do those distributors and representatives, or those six-thousand jobbers, what products do they handle? A. Well, our automotive line, which would include products such as Liquid Wrench, Motor-Medic, Transeal, Gunk Degreasers, Solder Seal, Radiator Repair.

Q. What "Medic" marks? A. Motor-Medic, Car-Medic and a new product which we have just introduced recently called Trans-Medic.

Q. You mentioned Car-Medic; is that the mark that is indicated in this registration? Registration 721,134 of September 5, 1961? A. Yes, that is right.

51 Q. Do you know how you were able to get a registration of Car-Medic?

THE COURT: That is utterly immaterial. If it is registered that settles it.

MR. DOWELL: I believe it shows, if the Court please --

THE COURT: It doesn't show anything except you used Medic for several different kinds of products that are made by the Radiator Specialty Company; isn't that it?

MR. DOWELL: No, sir.

THE COURT: What does it show?

MR. DOWELL: It shows that the Patent Office has granted a registration on Medic, granted one and refused another.

THE COURT: That is their privilege, their right and their prerogative.

MR. MOORE: Your Honor, I should like to correct Mr. Dowell on that. The Patent Office refused a registration on Motor-Medic. It has granted a registration on Car-Medic.

THE COURT: Yes, that is what I say. There is no point if they gave a registration on one compound word and not on another. Go ahead now, please.

MR. DOWELL: The only similarity between the two marks, if I make no mistake, is the word "Medic".

THE COURT: You have only to consider these two marks that are in
52 issue here. If registration has been granted on others containing the word "Medic" all right, but there is no pertinence though with respect to the issue in this case.

MR. DOWELL: We would like to introduce it.

THE COURT: What?

MR. DOWELL: Car-Medic, this registration.

THE COURT: Denied.

BY MR. DOWELL:

Q. I would ask the witness to identify Exhibits, or if you can identify Exhibits Marked for Identification 2, which is a container I hold in my hand, 3 another Motor-Medic container, 4 a third Motor-Medic container, which is a little longer cylinder with a point on the end, 5 the top of one of registrant's containers -- I will skip 6 for the moment -- 7 is a --

MR. MOORE: Your Honor, can't we take these one at a time?

THE COURT: I would think so, but I am just wondering why they are relevant here, why they should be introduced and why the Court should accept them. I have accepted a tremendous amount of stuff here today that is immaterial, to my way of thinking.

MR. MOORE: In my viewpoint, the case has to be decided upon the file wrapper and the registration.

THE COURT: I would think so. If you are going to introduce those
53 in evidence I am going to deny you the privilege of doing it. They are of no help to the Court and they have nothing to do with the issue.

MR. DOWELL: We need them in to have a full case, if the Court please.

THE COURT: I can't hear you. What did you say?

MR. DOWELL: We have introduced only one exhibit. That is Exhibit 7.

THE COURT: What?

MR. DOWELL: Exhibit 11 I mean. That is the magazine.

THE COURT: I let you put that in but I don't see the materiality of it at all, but you are not going to go any further. Things that the Court considers are irrelevant are not going to be introduced in evidence.

MR. DOWELL: Including the can on the market?

THE COURT: Yes, those cans will not be received in evidence.

MR. DOWELL: I presume from what the Court said there is no use to ask for the introduction of any additional evidence; is that correct?

THE COURT: That is up to you. You may try it. If the Court thinks it is relevant it will admit it; and if it thinks it is irrelevant it will accede to any objections made by defense counsel.

54 MR. DOWELL: As I understand it so far, the three containers --

THE COURT: They will not be received in evidence, those containers. There is no necessity --

MR. DOWELL: I just started to say that.

THE COURT: I have already said that three or four times, so don't argue.

MR. DOWELL: I was just trying to mention what was not received.

THE COURT: The Court will not receive it.

MR. DOWELL: I understand this top (indicating) --

THE COURT: That is included too.

MR. DOWELL: And the container --

THE COURT: That also.

MR. DOWELL: The magazine add of the competitors product, that will not be?

THE COURT: I would like to see it. Possibly it may have some relevance, but I doubt it. Show it to counsel.

MR. DOWELL: I have shown it to counsel, if the Court please, already.

MR. MOORE: This is marked Plaintiff's Exhibit 7 for Identification.

MR. DOWELL: I was going to have the witness identify it, but there is no use.

MR. MOORE: I object to it as irrelevant.

55 THE COURT: Let me see it.

I will overrule the objection. Mark it in evidence. It shows his product and your product are used for the same purpose.

THE DEPUTY CLERK: Plaintiff's Exhibit 7.

(Plaintiff's Exhibit No. 7 was received in evidence.)

MR. DOWELL: I want to offer Exhibit 8.

MR. MOORE: I object to it also as irrelevant.

THE COURT: Objection overruled.

THE DEPUTY CLERK: Plaintiff's Exhibit 8.

(Plaintiff's Exhibit No. 8 was received in evidence.)

BY MR. DOWELL:

Q. May I ask the witness, please, you have furnished these exhibits 7 and 8 to counsel? A. Yes, sir, we have.

Q. Can you identify those? A. Yes.

Shall I go ahead and identify them?

THE COURT: They speak for themselves.

MR. DOWELL: They speak for themselves.

BY MR. DOWELL:

Q. I have in my hand a couple of pamphlets. Could you tell me
56 what they are? A. The one in your righthand is our complete
catalogue as we print it; and the one in your lefthand is our complete
catalogue as printed by our Swiss distributor; our distributor in Switzer-
land. That one is in German and French.

MR. DOWELL: I would like to offer the first one, the U.S.

THE COURT: Well, to save time they may be received. Mark them.

THE DEPUTY CLERK: Plaintiff's Exhibits 9 and 10.

(Plaintiff's Exhibits No's. 9 and 10
were received in evidence.)

BY MR. DOWELL:

Q. I have in my hand a book, a scrap-book. Can you identify this?

THE COURT: What is it for? What does it contain?

MR. DOWELL: It contains ads of various kinds. I just wanted him
to state briefly --

THE COURT: Tell me, please, how they can be relevant to show
it is not confusing similarity between Auto-Medic and Motor-Medic?

MR. DOWELL: It shows advertisements throughout the nation.

THE COURT: Of what?

MR. DOWELL: Of the products that we are concerned with here,
57 Motor-Medic.

THE COURT: I guess counsel would say he will agree that it does
and that is all there is to it.

MR. MOORE: Yes, Your Honor.

THE COURT: Then you don't have to introduce it.

MR. DOWELL: That is all.

MR. MOORE: No cross examination, Your Honor.

THE COURT: Very well. Step down, Call your next witness.

MR. DOWELL: Mr. Herman Blumenthal.

Thereupon --

MR. HERMAN BLUMENTHAL

was called as a witness by and on behalf of the plaintiff and, having been first duly sworn, was examined and testified as follows:

DIRECT EXAMINATION

BY MR. DOWELL:

Q. Mr. Blumenthal, please state your full name, your age, your residence and your business. A. Herman Blumenthal, forty-seven. I live at Charlotte, North Carolina. I am vice-president, Radiator Specialty Company.

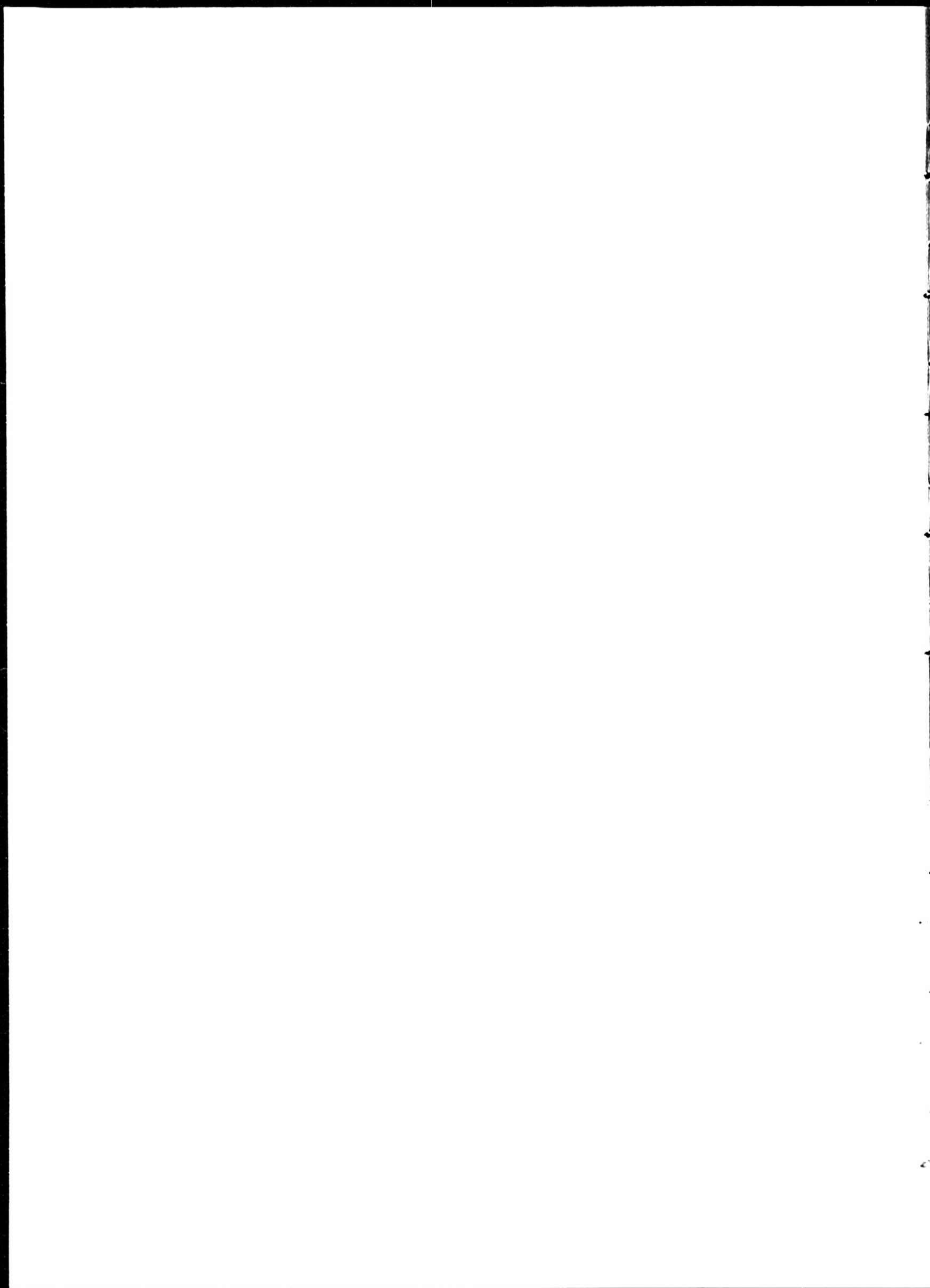
Q. How long have you been with Radiator Specialty Company? A. Since 1937.

58 Q. What was your experience before that? A. I got out of school in '34 and was in business with my father for several years before I joined Radiator Specialty Company.

Q. What is the business of Radiator Specialty Company? A. Radiator Specialty manufactures a line of automotive rubber items for the automotive, plumbing and hardware trade.

Q. You have heard the testimony of Mr. Hoffman who preceded you. Would you have anything to add to his testimony? A. Well, I would like to emphasize the fact that both we and the Wynn Company are nationally known companies who have been in business for many years. We have been in business almost forty years now. We are nationally known and have over Six-thousand accounts, active accounts on our books, employ over eighty salesmen in all fields, our own exclusive salesmen, and we have a number of registered trade-marks that are very well-known nationally. When we adopted this Motor-Medic mark there was not a product on the market by the name of Auto-Medic. When we got into it and started advertising and spent so much money developing and advertising Motor-Medic it was just impossible to change the name. We had our product Motor-Medic on the market for, I think, two years before the product Auto-Medic ever came

59 on the market. Whereas we are restrained from getting a registration, actually, we have been copied.



MR. MOORE: I object to this line of testimony. It is a collateral attack, Your Honor, on the registration.

THE COURT: It can't be done. The objection is sustained.

BY MR. DOWELL:

Q. State whether or not you agree with what Mr. Hoffman has testified? A. Yes, sir, I agree with all of it.

Q. What has been your contact with Motor-Medic, your salesmen and your outlets? A. I am not in as direct contact as Mr. Hoffman. He is the general sales manager, but I am the chief administrative officer and I am actually in contact with all departments, so I am thoroughly familiar with the program.

Q. Have you ever known of any instance of confusion? A. No, sir, I have not.

Q. Have you done considerable travelling about the territory? A. Yes, I have travelled around somewhat.

Q. What is the custom relative to your finding out about competitive products? A. We ask our salesmen as part of their jobs to tell us about every competitive product immediately as it comes upon the market, and
60 we keep quite an active file on competitive products to know what is going on at all times.

MR. DOWELL: That is all.

THE COURT: Have you any cross examination, Mr. Moore?

MR. MOORE: No cross examination, Your Honor.

THE COURT: Step down.

That completes your case?

MR. DOWELL: Yes, Your Honor.

THE COURT: Have you anything to offer?

MR. MOORE: The booklet has been offered. That is all, Your Honor.

THE COURT: Very well. I will hear arguments now.

Mr. Dowell, you may make your closing argument.

MR. DOWELL: If the Court please.

Our client, the applicant here for registration of the trade-mark Motor-Medic, urges that it is entitled to that registration. The decisions

of the Patent Office have not gone far enough in considering the marks. The word "Medic" is a generic term. It is indicative of association with medicine, or something which is relied upon to relieve, improve, correct or cure a situation or condition. It is a dictionary word. We have studied quite extensively the dictionary. It is a dictionary word derived from the Latin word "medica" meaning a kind of cloverlike ~~earth~~ [herb] used as a medicine. It also means physician. According to the dictionary, a physi-
 61 cian is a healer or restorer. These additives are put in the oil to give a beneficial result.

Now the Patent Office has said that "Auto" means automobile. It has failed to say that "Auto" long before the time of the automobile was a common word. I noted some several columns in the dictionary. We have automatic and we have auto this and auto that.

Consequently, in order to have a good registration, we must have more than the word "Auto" or more than the word "Medic". Now this registration is a composite mark. It shows a number of features other than the mere words and, in fact, the words are subservient to the mark. It is even colored, lined for coloring.

Our client's registration, our client's application or our client's trademark, as it has been used widely and extensively and advertised expensively, consists of the words "Motor-Medic".

Now the Patent Office has taken the position that "Motor" means the motor of an automobile. But "Motor" means more than that. A motor can be a plain little simple motor in a child's toy that you wind. It can be the heart of the human body. It can be anything that supplies the power.

So "Motor-Medic" coupled together has a significance that is dif-
 62 ferent from "Auto-Medic".

"Auto" means "of itself", and whether it relates to an autobiography, automatic or anything else, it has a different connotation. The two taken jointly in their entirety, we claim, are distinctively different. And we can't overlook this: We have not been able to find, in all honesty, one instance of confusion other than the mechanic who said somebody looked for something and he didn't find it. He didn't say there was any confusion. Or what he said didn't amount to confusion in my book.

But now let's look at this thing from a viewpoint of equity. Here is a concern that has spent a lot of money. They have done a lot of advertising through the various media. The Patent Office is basing its refusal to register on the opinion of the Examiner that there is confusing similarity or likelihood.

We submit that we have unquestionably refuted that position, that our people should be permitted to register the trade-mark "MOTOR-MEDIC".

Thank you.

THE COURT: Mr. Moore?

MR. MOORE: If the Court please.

63 Our broad position is that there has not been presented here the evidence carrying thorough conviction that the decisions that control this Court require of a plaintiff seeking to overturn a specific finding of the Patent Office.

The evidence that there has been no confusion, for the most part, has come from interested witnesses. It suggests a negative anyway. The testimony of the mechanic, Marzullo, is significant here because it does bear upon the fact that there is confusion, at least, in this one instance. As I remember his testimony, it was to the effect that a party seeking to purchase a can of additive asked for Wynn's Motor-Medic, confusing Wynn's and the plaintiff's product.

Of course, this is a continuation of a statutory proceeding. We are not concerned here with what the plaintiff may do with respect to the merchandising of his product on the market. We are concerned here with whether there should be issued a registration to the plaintiff with the presumption that arises from the issuance of such a registration. The matter of use in the marketplace can be determined by an infringement suit if the owners of the registration is so advised. But that is not the issue before this Court.

The law of trade-marks is part of the law of the marketplace. It is eminently the practical aspect of the law. It doesn't do, we suggest,

to theorize here about "Auto" and "Motor". It is quite clear from the
64 context of the cases that "Motor" and "Auto" mean the same thing
here. Those two words have little trade-mark significance. The trade-
mark significance lies largely in the word "Medic". It is not a descrip-
tive word as applied here. We are not talking about "medic" in the
abstract. We are talking about "medic" as a part of two marks which are
used with respect to automobile products. Medic could be descriptive
in the context of surgical supplies. It couldn't be descriptive in connection
with a ring, for instance. It might have some connotation or suggestive-
ness with respect to a pair of shoes, but it doesn't even have that sug-
gestiveness with respect to automobile products.

In other words, it is impossible to talk in gross about trade-marks.
You must discuss them with respect to the products. You must discuss
them with respect to the trade.

With respect to the products and the trade here, it is clear to us, as
it was to the Trade-mark Trial and Appeal Board, that "MOTOR-MEDIC"
and "AUTO-MEDIC" are confusingly similar.

Now it isn't necessary that there be a holding of confusing similarity
for there to be an adjudication of refusal of registration in the Patent
Office. The statute merely calls for likelihood of confusing similarity.
And there is, as held by the Trade-mark Trial and Appeal Board, a
65 definite likelihood here, because the marks in their significant
portions are so much alike; and considered in their entirety, as they must
be, they do resemble each other to an extent that there is confusing
similarity. That is emphasized by the fact that here it has been admitted
-- and it would have been shown clearly if it hadn't been admitted -- that
the products are identical. And certainly they are identical with respect
to the descriptions as given in the application on the one hand and in the
registration on the other.

We suggest that there is clear basis for a decision in favor of the
Patent Office.

THE COURT: Mr. Dowell?

MR. DOWELL: If the Court please, this oil additive is supposed to be a controller or something to improve the operation, as medicine does; and I can't understand how he can say it has nothing to do with the nature or doesn't suggest what it is. He said you have to completely detach it. That is what I understood from listening to him. That is the sum and substance of it. But it seems to me that it is, in fact, a type of medication that you put in the oil. And it may not react quite the same as it would on a human being, but it is still a type of medication. And

66 to say you can't consider it that way, we can't agree with.

We submit that there is a connotation there medic is clearly in the public domain and you have to have the coupling of the words, and when you get them there is no similarity.

Thank you.

THE COURT: The Court proposes to rule on this issue from the bench now.

We have "AUTO-MEDIC" registered.

We have "MOTOR-MEDIC" sought to be registered.

There has been a great sale of MOTOR-MEDIC, undoubtedly. Surely a lot of money has been spent. All right, but there is nothing to indicate it has been wasted because there is a great distinction between use and registration.

As was mentioned by the Solicitor, it is the likelihood of confusion. The Court has read the decisions of the two Patent Office tribunals and agrees with them. As a matter of fact, the Court cannot imagine any two terms that are so likely to cause confusion, considering the purpose for which they are used, which is practically identical, than AUTO-MEDIC and MOTOR-MEDIC. People refer to an automobile as an auto. Many others refer to an automobile as a motor.

So the Court is quite clear, in its opinion, that the evidence adduced

67 here at this hearing is not sufficient to overcome the strong presumption that attaches to the decision of the Trade-mark Trial and Appeal Board below.

Therefore, judgment will be rendered for the defendant and against the plaintiff.

The defendant will prepare proposed findings of facts and conclusions of law and an order.

Court now stands adjourned until tomorrow morning at 10:00 o'clock.

(Whereupon, at 12:10 p.m. the trial of Civil Action No. 1278-62, Radiator Specialty Company versus David L. Ladd, Commissioner of Patents, was concluded.)

[Filed Sept. 24, 1958]

**EXCERPTS FROM
PLAINTIFF'S EXHIBIT 1**

IN THE UNITED STATES PATENT OFFICE

59489

MARK: MOTOR-MEDIC
CLASS NO. 15

TO THE COMMISSIONER OF PATENTS:

STATEMENT

RADIATOR SPECIALTY COMPANY, a corporation duly organized and existing under the laws of the State of North Carolina, and having its principal place of business at 1400 West Independence Boulevard, Charlotte, North Carolina:

The above identified applicant has adopted and is using the trade-mark shown in the accompanying drawing, for OIL ADDITIVE FOR INTERNAL COMBUSTION ENGINES, and requests that said mark be registered in the United States Patent Office on the Principal Register established by the Act of July 5, 1946.

The trade-mark was first used on the goods on September 12, 1958; was first used in interstate commerce on September 18, 1958; and is now in use in such commerce.

The mark is used by printing directly upon the containers, by means of suitable labels, or in any other desired manner, and five specimens showing the mark as actually used are presented herewith.

[Filed Sept. 24, 1958]

DECLARATION

STATE OF NORTH CAROLINA)
)
COUNTY OF MECKLENBURG) SS:

HERMAN BLUMENTHAL, being sworn, states that: he is the Vice-President of the applicant corporation and is authorized to execute this affidavit on behalf of said corporation; he believes said corporation to be the owner of the mark sought to be registered; to the best of his knowledge and belief no other person, firm, corporation or association has right to use said mark in commerce, either in the identical form or in such near resemblance thereto as might be calculated to deceive; and the facts set forth in this application are true.

RADIATOR SPECIALTY COMPANY

By

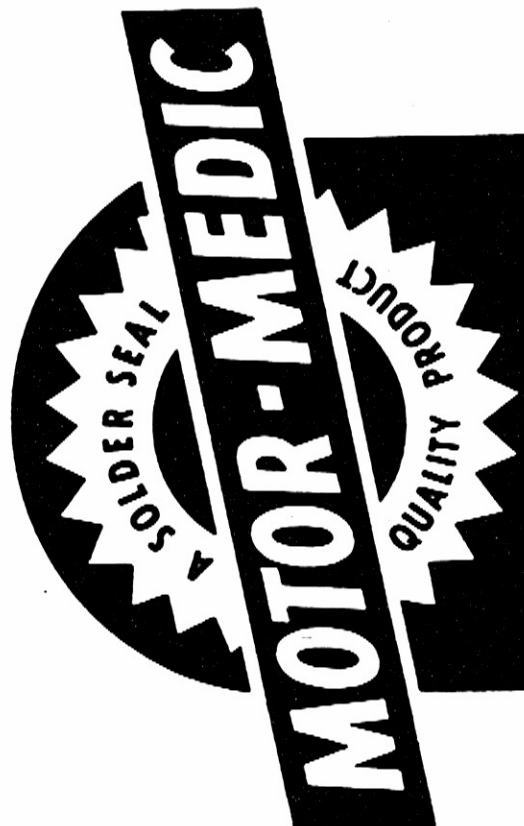
/s/ Herman Blumenthal
Vice-President

Subscribed and sworn to before me this 22nd day of September,
1958.

/s/ Elizabeth L. Stephens
Notary Public

My Commission Expires: 8-17-60

(SEAL)



THICKENS OIL WHEN HOT
THINS OIL WHEN COLD

**STOPS OIL
BURNING
STOPS EXHAUST
SMOKING**

INCREASES GAS MILEAGE
INCREASES OIL PRESSURE
QUIETS NOISY MOTORS

FOR AUTOS, TRUCKS,
BOATS, TRACTORS.

**WATCH THE MAGIC BUBBLE!
TURN THE JAR OVER**

MOTOR-MEDIC is the new miracle polymer which improves engine performance quickly. Stops oil burning and exhaust smoking. quiets noisy motors, saves gas, raises compression and oil pressure.

DIRECTIONS FOR USE!

MOTOR MUST BE RUNNING AND THOROUGHLY WARM WHEN ADDING SOLDER SEAL MOTOR-MEDIC. Pour contents of jar into crankcase with motor idling. For best results, change oil before adding SOLDER SEAL MOTOR-MEDIC.

Use 1 jar for each 6 quarts of oil and at each oil change. Use 2 jars for older motors (over 25,000 miles) or where oil burning is heavy. Run motor at fast idle for at least 15 minutes after adding SOLDER SEAL MOTOR-MEDIC.

GUARANTEED

Mixes perfectly with all motor oils when used as directed. Will not harm oils or motors. Non clogging, non-corrosive non-foaming.

RADIATOR SPECIALTY COMPANY

CHARLOTTE, N.C.
RADIATOR SPECIALTY CO. OF CANADA LTD. TORONTO

444 LITERS 15 FL OUNCES

S-58-314

RADIATOR SPECIALTY CO # 6115

LH 3106

95

48

59489

Radiator Specialty Company

1400 West Independence Blvd., Charlotte, N. C.

First Use: September 12, 1958

First Interstate Use: September 18, 1958

For: OIL ADDITIVE FOR INTERNAL
COMBUSTION ENGINES

MOTOR-MEDIC

PROPRIETOR
RADIATOR SPECIALTY COMPANY

BY

Hyatt Dowell

ATTORNEY

3

5

* * *

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
Washington

* * *

A. Yates Dowell &
A. Yates Dowell, Jr.
1345 Pa. Ave., N.W.,
Washington 4, D. C.

Mailed: SEP 12 1960
Ser. No. 59,489
Applicant: Radiator Specialty
Company

Responsive to communication filed May 16, 1960.

Careful consideration has been given to applicant's arguments but it does not appear that there is sufficient dissimilarity between the marks and goods in question to warrant contemporary registrations to both parties. As applied to automobile motor oil additives, the words AUTO and MOTOR have very little trademark significance. Both AUTO and MOTOR are commonly used as component parts of trademarks. On the other hand, the word MEDIC, as applied to oil additives, is arbitrary and has no particular meaning. In determining the question of the confusingly similarity of trademarks, the marks must be considered in their entirety, but this doctrine is not inconsistent with the rule that one word may be the most prominent part thereof and entitled to greater force and effect than other parts of the mark. It appears that the word MEDIC is the most prominent feature of both applicant's and the registrant's marks and it is believed that purchasers would be more likely to remember the prominent feature as indicating origin of the goods. It is also believed that the meaning and suggestive connotation of AUTO-MEDIC and MOTOR-MEDIC, as applied to oil additives, are nearly identical.

Registration No. 651,646 is considered to be a pertinent reference and the refusal to register applicant's mark in view thereof is made FINAL.

Appeal period expires 60 days from this date.

/s/ G. R. Leader
EXAMINER, DIV. I

(MOTOR-MEDIC)
G. LEADER:aec

* * *

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
Washington

* * *

A. YATES DOWELL &
A. YATES DOWELL JR.
1345 PA. AVE. N. W.
WASHINGTON 4, D. C.

Mailed MAR 23 1961
Ser. No. 59,489
Applicant: RADIATOR SPECIALTY
COMPANY

Responsive to communication filed March 7, 1961.

The refusal which was made final on September 12, 1960, is withdrawn for the purpose of considering applicant's latest arguments.

The arguments submitted have been considered but the Examiner is still of the opinion that applicant's mark is not registrable in view of the reference registration. In addition to the decisions previously cited, it appears that the following decision also supports the Examiner's holding: In re Fishery Products, Inc., 125 USPQ 533 ("Ocean Club" for frozen fish held confusingly similar to "Sea Club" for canned salmon).

The refusal of record is again made FINAL.

Appeal period expires 60 days from this date.

/s/ G. R. Leader
EXAMINER, DIV. I

(MOTOR-MEDIC)
G. R. LEADER:bjw

AUG 1 1961

IN THE UNITED STATES PATENT OFFICE

Applicant : Radiator Specialty Company :
Trademark: MOTOR-MEDIC :
Serial No. : 59,489 : BEFORE THE
Filed : September 24, 1958 : TRADEMARK TRIAL
Attorney : A. Yates Dowell & : AND APPEAL BOARD
A. Yates Dowell Jr. : ON APPEAL
Address : 1345 Pa. Ave. N.W. :
Washington 4, D. C.

EXAMINER'S STATEMENT

This statement answers applicant's appeal from the refusal to register the instant mark in view of prior registration No. 651,646 which covers the mark AUTO-MEDIC and design for lubricating oil additives.

The Examiner is of the opinion that there is not the degree of dissimilarity between the marks in question as is contended by applicant. As applied to automobile motor oil additives, the words AUTO and MOTOR have very little trademark significance. Both AUTO and MOTOR are commonly used as component parts of many trademarks. It is believed that the terms "auto oil additives" and "motor oil additives" have substantially identical meanings. On the other hand, the word MEDIC, as applied to oil additives, is arbitrary and has no particular meaning. The word "medic" is defined as (a) "a physician" and (b) "a medical student."

It is believed that use of the terms AUTO-MEDIC and MOTOR-MEDIC on automobile motor oil additives by different parties would be very likely to cause confusion in trade as to origin of such goods. It is true that a side-by-side comparison would probably distinguish between those two marks but prospective purchasers are not always afforded the opportunity of making such comparisons. In determining the

question of the confusing similarity of trademarks, the marks must be considered in their entirety, but this doctrine is not inconsistent with the rule that one word may be the most prominent part thereof and entitled to greater force and effect than other parts of the mark. It appears that the word MEDIC is the most prominent feature of both applicant's and the registrant's marks and it is believed that purchasers, particularly prospective purchasers relying on recollection and recommendation, would be more likely to remember the prominent feature as indicating origin of the goods. The meaning or suggestive connotation of AUTO-MEDIC and MOTOR-MEDIC, as applied to automobile motor oil additives, is believed to be nearly identical. The decisions in the following cases appear to support the Examiner's holding in this case: *Pesquera Del Pacifico, S. De R. L. v. Hardee*, 115 USPQ 359; *Grate, doing business as Grate Machine Co. v. Mohawk Engineering Corp.*, 122 USPQ 407 and *In re Fishery Products, Inc.*, 125 USPQ 533.

For the reasons mentioned in this statement, it is believed that the registration sought, on appeal, should not be granted in view of Section 2(d) of the Trademark Statute.

/s/ G. R. Leader
EXAMINER, DIV. I

G. R. LEADER:bjw

Hearing:
October 18, 1961

SBC
Paper No. 13

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE

Trademark Trial and Appeal Board

In re Application of
Radiator Specialty Company

Application for Principal Registration of a trademark for
an oil additive for internal combustion engines,
filed September 24, 1958, Serial No. 59,489.

A. Yates Dowell and A. Yates Dowell, Jr. for applicant.

Before Leach, Waldstreicher and Lefkowitz, Members.

Opinion by Waldstreicher, Member:

An application has been filed by Radiator Specialty Company to register "MOTOR-MEDIC" for an oil additive for internal combustion engines. Use since September 12, 1958 is asserted.

Registration has been refused on the ground that applicant's mark so resembles the compound mark of "AUTO-MEDIC" and design previously registered for lubrication oil additives⁽¹⁾ as to be likely to cause confusion, mistake or deception of purchasers.

⁽¹⁾ Reg. No. 651,646, issued Sept. 17, 1957 to Wynn Oil Company.

Applicant has appealed.

It is applicant's contention that "MOTOR-MEDIC" and "AUTO-MEDIC" neither look nor sound alike, and their meanings are sufficiently dissimilar to avoid confusion.

The word "motor" is defined in Webster's New International Dictionary, Second Edition, Unabridged, 1947, as "of or pertaining to automotive vehicles". Applicant's specimens indicate that applicant's product is principally for use in automotive vehicles. The term "auto" is short for automobile. The compound terms "MOTOR-MEDIC" and "AUTO-MEDIC", as applied to goods identical in kind, have the same meaning and create the same commercial impression. Confusion among purchasers would be more than likely to occur.

Decision:

The refusal of registration is affirmed.

/s/ H. Waldstreicher

/s/ M. Leach

/s/ S. Lefkowitz

Members, Trademark
Trial and Appeal Board

FEB 20 1962

If you're expecting



then take
AUTO-MEDIC'S
advice:



Keep It new with WYNN'S FRICTION PROOFING

If you're planning on buying a new car, start it out to a long and healthy life of new car performance with a prescription from Auto-Medic-WYNN'S FRICTION PROOFING. It's the best medicine to keep new cars new.

Wynn's Friction Proofing goes right to work in new cars...safeguards you against future troubles. Friction Proofing* actually impregnates metal--doesn't merely coat it over with a thin film that soon disappears. Its unique sealing action drastically reduces friction between moving metal parts...and friction is the worst enemy your car's engine can have.

You will really feel the difference when Wynn's Friction Proofing goes to work on your automatic transmission. It reduces jerking...makes your gears shift easily and smoothly. Insures you against costly and complicated transmission repairs.

Make your new car a Wynn and it will be a miser with gas and oil--a spendthrift with

pep and power. Protect the investment you put into your new automobile with Wynn's Friction Proofing--and you'll get true new car performance for a long time to come. And if you're not planning on buying a new car, add Friction Proofing* to your present one...discover how much better it will perform. Ask your new car dealer, service station or garageman to add Friction Proofing* to your car today. Insist on the finest...Wynn's Friction Proofing...the can with the red and black bullseye.

IMPORTANT: Wynn's Radiator Additive is a must for new cars! Containing exclusive Friction Proofing*, Wynn's Radiator Additive prevents sludge resulting from water seepage...increasing engine efficiency.

FREE BOOKLET! Get your free booklet on Trouble Free Driving at your new car dealer. Or write Wynn Oil Company, Dept. L, 1151 West Fifth St., Azusa, California.

FOR
YOUR
CAR'S HEALTH



USE
ALL
FOUR



WYNN'S FRICTION PROOFING...THE *Proof* IS IN THE *Performance!*

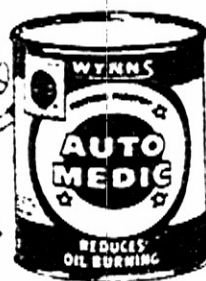
WYNN'S FRICTION PROOFING Products also available in Canada and everywhere in the free world.

*Friction Proofing is Wynn's trade mark for its exclusive metal conditioner which reduces friction between moving metals by chemically smoothing and sealing the surfaces. Manufactured by Wynn Oil Company, 1151 West Fifth Street, Azusa, California, U. S. A.

PLAINTIFF'S
EXHIBIT

NEW!

WYNN'S AUTO-MEDIC



**REDUCES
EXHAUST
SMOKING!**

**REDUCES
OIL BURNING!**

© Wynn Oil Company 1956

AUTO-MEDIC is the only product of its kind containing Wynn's Friction Proofing. Available at service stations, garages, new car dealers and wherever automotive products are sold throughout the United States and every country of the free world.



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- SPECIAL SERVICE ON ODD MAKES
- WE BUY DAMAGED BUMPERS

NEW VISCOSITY IMPROVER POURS AT -34° F.

Developed by the Wynn Oil Company after exhaustive laboratory and field performance tests, this newest member of Wynn's Friction Proofing line is fast establishing itself as one of the finest oil viscosity improvers on the North American market today.

Called Auto-Medic, the new additive has the outstanding quality of pouring easily at temperatures as low as minus 34 degrees Fahrenheit. To date, few, if any, other oil viscosity improvers have offered this special winter use advantage to motorists.

In addition, Auto-Medic, like all other Wynn products, contains a special metal conditioner which reduces friction between moving metals by chemically smoothing and sealing the surfaces. Auto-Medic reduces oil burning, improves compression, increases gasoline mileage and quiets noisy engines. It also prolongs the life of spark plugs, and a can of it added to the crankcase oil after installing new plugs will give the motorist exceptionally good engine performance and maximum spark plug service.

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AUTOMOTIVE PRODUCTS

Effective March 1, 1961

Catalog No. 1-R

PLAINTIFF'S
EXHIBIT

2
F.D.

RADIATOR SPECIALTY COMPANY, CHARLOTTE, N.C.

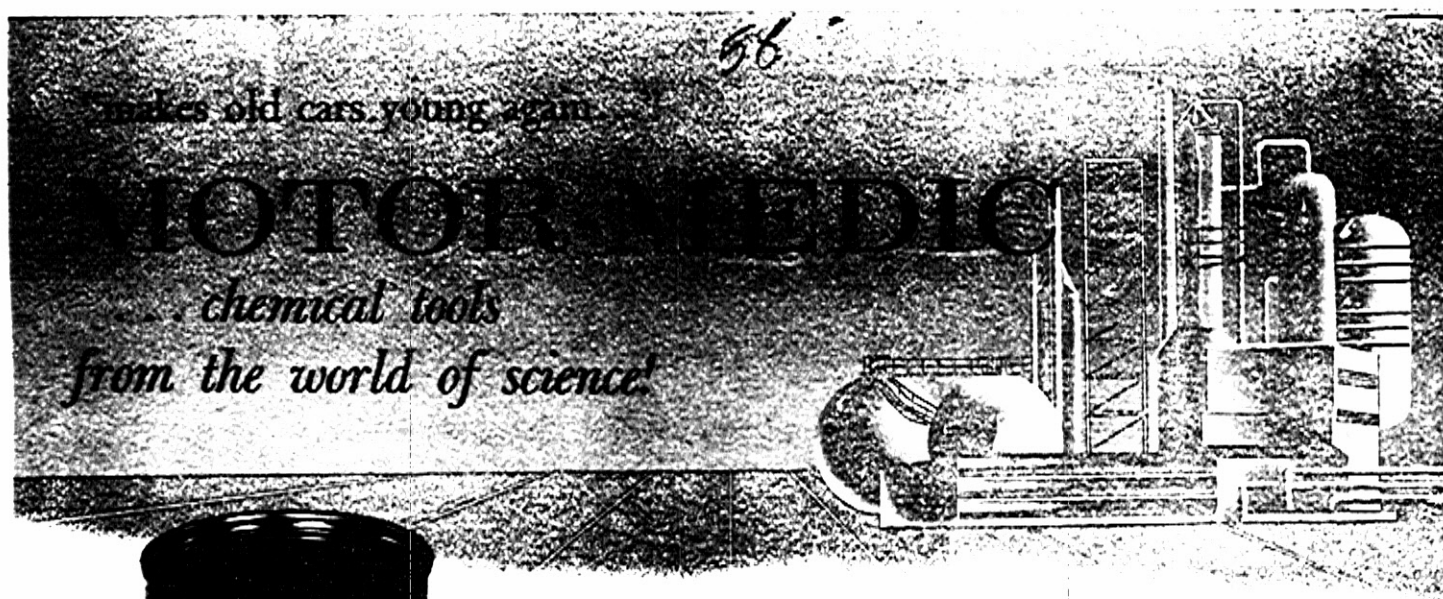


Solder Seal

Chemical Tools

Your Complete Line of
Automotive Chemicals... Always
Available from your Friendly, Local
Jobber, who is in Business to Serve You.

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*chemical tools
from the world of science!*



No 1

A super-concentrated treatment to provide maximum engine power. MOTOR-MEDIC is the new miracle oil soluble polymer that improves engine performance quickly. Not to be confused with tune-up solvents, break-in oils, extreme pressure lubricants and detergents. Use MOTOR-MEDIC in any car to stop oil-burning, exhaust-smoking, increase compression through better ring seal, increase power by eliminating "blow-by," increase oil pressure, reduce friction and wear, reduce piston slap, valve and lifter noise, lengthen life of spark plugs, cut costly motor repairs.

Add 1 can of MOTOR-MEDIC with each oil change. In cars burning oil heavily, add 2 cans.

No 2

Added to gasoline, MOTOR-MEDIC NO. 2 is the new scientific blend of solvents, lubricants and inhibitors for effective treatment of sluggish engines. Helps restore lost power, increases gas mileage, too. The modern "pep-tonic" for tired, sluggish cars. Gives them new life and pep . . . more power . . . more gas mileage and improved performance quickly. Repeat sales make it one of your most profitable chemical tools.

Helps restore lost power, increases gas mileage, cleans carburetor on-the-engine. Cleans and frees sticky valves and rings, removes gums, varnish, carbon from internal parts. Prevents stalling and carburetor icing, prevents pre-ignition. Provides lubrication for upper cylinder and valves. Prevents corrosion in gasoline system and upper engine parts.



	PART NO.	SIZE	CASE CONT.	CASE WT.	LIST PRICE
No. 1 (JAR)	M-18	15-Oz.	12	20 Lbs.	\$1.50
No. 1	M-19	15-Oz.	24	27 Lbs.	\$1.35
No. 2	M-26	16-Oz.	24	28 Lbs.	\$1.35

PLAINTIFF'S
EXHIBIT

PRODUCTS OF THE MONTH

Looking for all the world like a blood transfusion in action, at a modern hospital, is the artwork on the **FACT SHEET** of the Radiator Specialty Company's latest chemical innovation, **TRANS-MEDIC**. In a sense of the word that is precisely what **TRANS-MEDIC** does to an automobile's transmission. It gives life giving positive lubrication to one of the car's major parts... the transmission. For the past three years **TRANS-MEDIC** has been subjected to the most rigid per-



formance tests using every imaginable "hard-to-solve" conditions. In every case **TRANS-MEDIC** came through with flying colors and now is available through a number of alert jobbers. **TRANS-MEDIC** just had to be good to take its place alongside the other Radiator Specialty Company products, which enjoy such enviable reputation. Place your order today to start serving your customer tomorrow.

Pitch-Board, a transparent clipboard that holds removable paper inserts, gives service stations a new means of advertising their services directly to credit card customers.

Lightweight and hard-surfaced, the clipboard is molded from tough



Tenite butyrate plastic in two parts—upper and lower faces—which include a resilient clip and which are fitted together on three sides in neat, clever assembly. The fourth edge is open to permit the advertising insert to be slipped inside, where it is fully displayed but protected from dirt, grease and moisture.

Measuring 7 x 9 inches, the clipboard provides a comfortable writing surface for the customer when he signs his receipt. Meanwhile, it also presents him with a message about car care at exactly the place and time when he can most readily respond to it.



Phillips Petroleum Company is building traffic at its 66 service stations by distributing a new Stan Musial recording titled "Stan-the-Man's Hit Record," above. Record and accompanying illustrated brochure provide batting pointers for baseball fans of all ages.



Model Kathy Gist solves her hot weather problem by sitting on a block of ice, but dealers can solve summer car troubles with the aid of this new display from Wynn's Friction Proofing. In warm weather oil and automatic transmission fluid tend to thin out—often causing excessive oil consumption and leaking transmissions. The "Stop Hot Weather Trouble" display points to the benefits of adding Wynn's Auto-Medic to the oil, Wynn's Transmission Stop-Leak to the transmission fluid to prevent these problems. During the June-July promotion Wynn's will offer dealers six free cans of Auto-Medic or three free cans of Transmission Stop-Leak with every case of Auto-Medic they buy.

DEFENDANT'S EXHIBIT 1

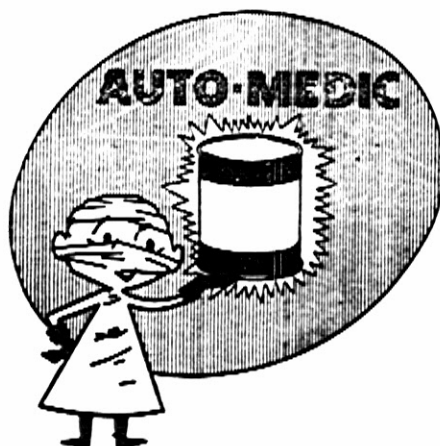
United States Patent Office

651,646

Registered Sept. 17, 1957

PRINCIPAL REGISTER Trademark

Ser. No. 20,814, filed Dec. 10, 1956



Wynn Oil Company (California corporation)
1151 W. 5th St.
Azusa, Calif.

For: LUBRICATING OIL ADDITIVES, in CLASS 15.
First use Oct. 12, 1956; in commerce Oct. 12, 1956.
The drawing is lined to indicate the colors red and yellow.

[Filed June 28, 1963]

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

RADIATOR SPECIALTY COMPANY,)	
)	
Plaintiff,)	
)	
v.)	CIVIL ACTION NO. 1278-62
)	
DAVID L. LADD,)	
Commissioner of Patents,)	
)	
Defendant.)	

MEMORANDUM OPINION

This is a civil action brought by plaintiff pursuant to 35 U.S.C. 145, and Section 21 of the Trademark Act of July 5, 1946 (15 U.S.C. 1071) in which plaintiff seeks to have this Court authorize defendant, Commissioner of Patents, to register on the Principal Register, its mark "MOTOR-MEDIC", for an oil additive utilized by internal combustion engines.

Plaintiff filed his application in the patent Office on September 24, 1958, in which he asserted use of "MOTOR-MEDIC" since September 12, 1958. Subsequent thereto, the Patent Office, in pursuance of Section 2(d) of the Act of July 5, 1946 (15 U.S.C. 1052(d) refused registration on the ground that the mark of plaintiff's application so resembled the compound mark "AUTO-MEDIC" previously registered for lubricating oil additives (Registration No. 651,646, issued September 17, 1957 to Wynn Oil Company) as to be likely to cause confusion, mistake, or deception to purchasers.

It is plaintiff's contention that "MOTOR-MEDIC" and "AUTO-MEDIC" neither look nor sound alike, and their meanings are sufficiently dissimilar to avoid confusion.

In considering whether marks have a confusing similarity three considerations are relevant - appearance, meaning, and sound. McKinnon & Co. v. Hyvis Oils, Inc., 88 F.2d 699. It appears that the Patent Office properly considered this standard. As applied to automobile motor oil additives, the words "Auto" and "Motor" have very little trademark

significance. Both of these terms are commonly used as pertinent parts of many trademarks. It would seem that the terms "Auto Oil Additives", and "Motor Oil Additives" have substantially the same meaning. The word "Medic" has been defined as a "Physician" and a "Medical Student". As applied to oil additives, the word "Medic" has no particular meaning.

The most significant and prominent phase of both of the above-mentioned marks is the word "Medic", and it would be very likely that prospective purchasers would be more likely to remember the prominent feature as indicating origin of the goods.

While it is true that a side-by-side comparison of these two terms would properly distinguish them, prospective purchasers are not always afforded the opportunity of making such comparisons, and the Court finds that the use of these two terms would be very likely to cause confusion, mistake or deception to purchasers.

Although several of plaintiff's witnesses testified that in their experience no confusion had occurred between these two products, the likelihood of confusion was suggested by one of plaintiff's own witnesses on direct examination:

Q. By Mr. Dowell:

Are you familiar with Motor-Medic?

A. Yes.

Q. By Mr. Dowell:

And Auto-Medic?

A. Yes.

Q. Have you ever known of any confusion in the minds of anyone that approached you? In other words, have you ever known of any confusion in these products?

A. Not myself, but a couple of days ago there was a confusion with a customer.

Q. What was that?

A. A customer came in and asked for a can of Wynn's Motor-Medic and we told him we didn't have Wynn's Motor-Medic. We told him we had different brands. And this was an employee of mine that told me that this morning.

Q. When I called you on the phone yesterday you told me you had never heard of any confusion; is that correct?

A. I haven't myself; no.

(Testimony of Frank Marzullo, p. 41 of Court Transcript).

In seeking to compel the Commissioner of Patents to grant registration of a trademark, plaintiff has the burden of proof. Safeway Stores, Inc. v. Dunnell, 172 F.2d 649, Cert. Denied. 337 U.S. 907, and furthermore, the plaintiff must show by clear and convincing evidence that the Commissioner's decision was erroneous and that plaintiff was entitled to register the disputed trademark. Century Distilling Co. v. Continental Distilling Co., 106 F.2d 486, Cert. Denied. 309 U.S. 662. The findings of the Patent Office are not to be overturned lightly. Larsen v. Marnell, 90 U.S. App. D.C. 260, 195 F.2d 200, and as pronounced continuously by the Supreme Court, and the U. S. Courts of Appeals, a finding of fact by the Patent Office as to confusing similarity of marks must be accepted as controlling unless the contrary is established by evidence which in character and amount carries thorough conviction. Morgan v. Daniels, 153 U.S. 120.

A mere preponderance of evidence is not sufficient, for the Patent Office is an expert body pre-eminently qualified to determine questions such as are involved herein.

The evidence produced by plaintiff at the trial is not sufficient to overcome the strong presumption that attaches to the decision of the Patent Office tribunals. Esso Standard Oil Co. v. Sun Oil Co., et al., 97 U.S. App. D.C. 154, 229 F.2d 37.

In view of the foregoing discussion the Court finds that the plaintiff is not entitled to the trademark registration for which he made application, and the Complaint should be dismissed. What has been said hereinbefore shall constitute findings of fact and conclusions of law.

DATED: June 28, 1963.

/s/ JOSEPH R. JACKSON
JUDGE

[Filed June 28, 1963]

JUDGMENT

This action came on to be heard on June 5, 1963, and thereupon, upon consideration thereof, it is this 28th day of June, 1963,

ADJUDGED that the Complaint be, and it is hereby dismissed, with costs against plaintiff.

/s/ JOSEPH R. JACKSON
JUDGE

[Filed July 29, 1963]

NOTICE OF APPEAL

Notice is hereby given this 29th day of July, 1963, that it hereby appeals to the United States Court of Appeals for the District of Columbia from the judgment of this Court entered on the 28th day of June, 1963.

/s/ A. Yates Dowell
Attorney for
Radiator Specialty Company

THIEL & CASILLAS
209 C Street, N.W.
Washington 1, D.C.
Telephone 393-0625, 393-7217

7-2-6
BRIEF FOR APPELLEE

IN THE
United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA CIRCUIT

—
Appeal No. 18,087
—

RADIATOR SPECIALTY COMPANY, APPELLANT

v.

DAVID L. LADD, Commissioner of Patents, APPELLEE

—
Appeal From The Judgment Of The United States
District Court For The District of Columbia
—

CLARENCE W. MOORE,
Solicitor, United States Patent Office
Attorney for Appellee.

United States Court of Appeals
for the District of Columbia Circuit

FILED NOV 21 1963

Nathan J. Paulson
CLERK

APPEAL NO. 18,087

STATEMENT OF QUESTION PRESENTED

In the opinion of appellee, the single question is:

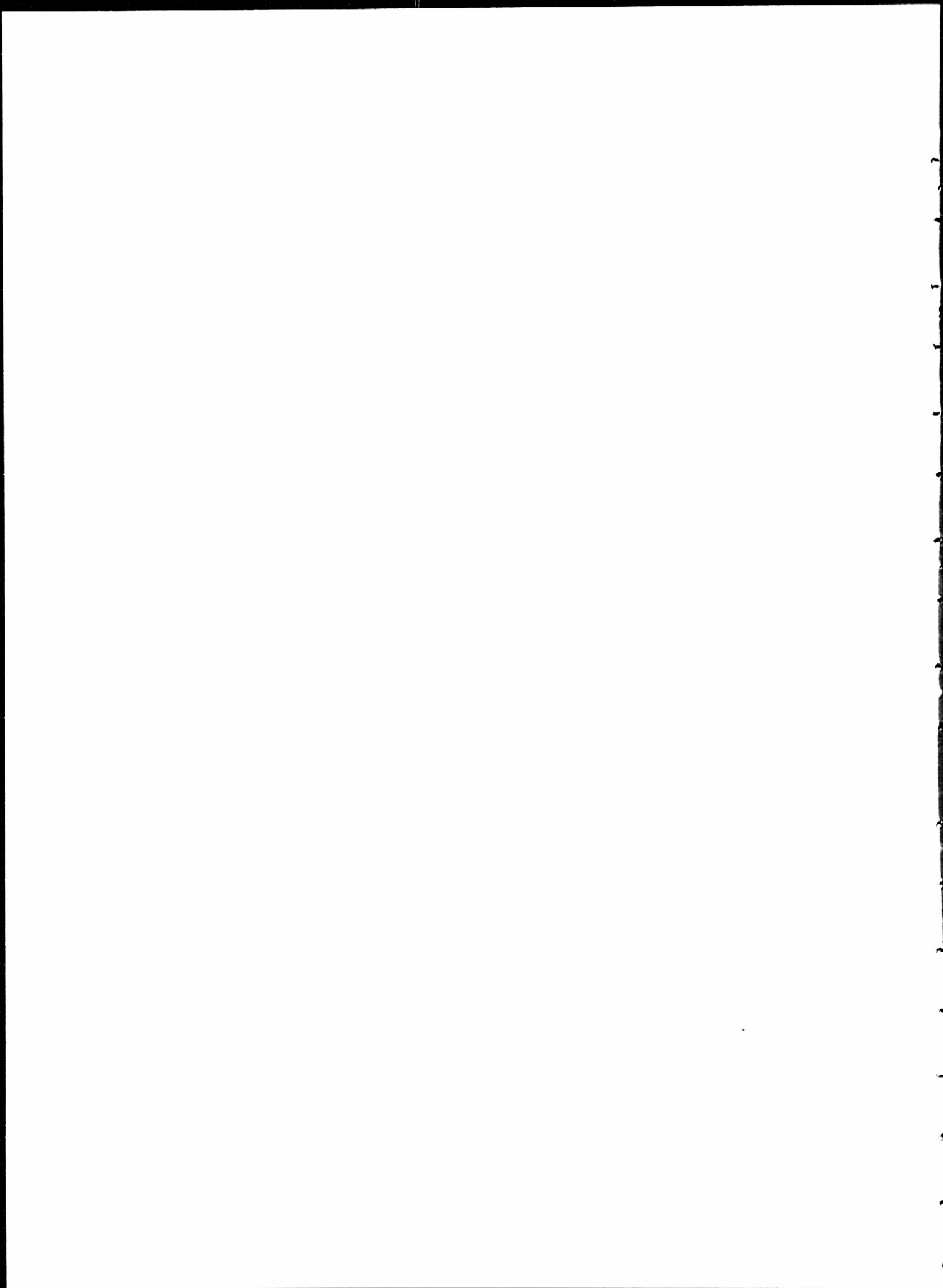
Did the District Court commit reversible error in finding, with the tribunals of the Patent Office, on the issue presented to them and to it, that, as applied to oil additives, "Motor-Medic" and "Auto-Medic" are confusingly similar.

III

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* Cases chiefly relied upon are marked by asterisks.



IN THE
United States Court of Appeals
FOR THE DISTRICT OF COLUMBIA CIRCUIT

Appeal No. 18,087

RADIATOR SPECIALTY COMPANY, APPELLANT

v.

DAVID L. LADD, Commissioner of Patents, APPELLEE

Appeal From The Judgment Of The United States
District Court For The District of Columbia

BRIEF FOR THE COMMISSIONER OF PATENTS

JURISDICTIONAL STATEMENT

The civil action under review, in which the appellant sought, unsuccessfully, to have the District Court authorize the issuance to it of the trademark registration for which it made application in the Patent Office on September 24, 1958, under Serial No. 59,489 (J.A. 45 to 48), was brought (Complaint, J.A. 2)

pursuant to the provisions of 15 U.S.C. 1071 (Section 21 of the Trademark Act of July 5, 1946, ch. 540, 60 Stat. 427, 435), as amended by Public Law 593, 82nd Cong., approved July 19, 1952, ch. 950, 66 Stat. 792, 814 and 815, and par. (c) of Public Law 609, approved August 8, 1958, 72 Stat. 540, and the provisions of 35 U.S.C. 145 (Patent Act of July 19, 1952, ch. 950, 66 Stat. 792, 803), to which the specified section of the trademark statute then made particular reference. The civil action was brought on April 19, 1962 (J.A. 1 and 2). Subsequent to that date and on October 9, 1962, Public Law 87-772, 76 Stat. 769, 772 and 773, was enacted, amending, *inter alia*, said section 21 of the trademark statute, 15 U.S.C. 1071.

Contrary to appellant's allegation (Brief, page 2, first paragraph), jurisdiction of the District Court was not based on 28 U.S.C. 1338.

COUNTERSTATEMENT OF THE CASE

Because the testimony of the witnesses for appellant at the trial is not so specific and definite on the matter of confusing similarity of marks as its "Statement of Case" (Brief, pages 4 to 6) would indicate, suggest, or imply, a counterstatement on the part of appellee would seem necessary.

Thus, appellant's witness and vice-president, Herman Blumenthal, merely answered (J.A. 39) the broad question "Have you ever known of any instance of confusion" by saying "No, sir, I have not", making no reference to any "Wynn product" (*cf.* Brief for Appellant, page 4, fourth paragraph).

Again, appellant's witness and general sales manager, David Hoffman, made no reference, on the matter of confusion (or even otherwise), to the "composite trademark" of "Wynn Oil Company" (cf. Brief for Appellant, page 5, fourth and fifth sentences). His testimony (J.A. 33 and 34) on such matter reads, as follows:

Q. Have you received any reports of instances of confusion as a result of your use of the term "Motor-Medic" as a trade-mark and the competitive product "Auto-Medic"? A. Not a single one.

Q. Do you know of anyone who has heard of any confusion in your company? In other words, you have covered everything that you have heard relative to other people too, I presume? A. To the best of my knowledge, no one else has either.

Q. Have you made any special inquiry to determine whether there have been any instances of confusion or conflict? A. Yes, sir, we did. We instructed our salesmen to investigate a representative sampling of the trade, dealers in their territories, and to report to us.

Q. In what territories? A. All over the country. And the results of that investigation, based on our salesmen's reports of interviews in the field, was that they ran across no confusion. As a matter of fact, during the course of that investigation our salesmen were given affidavits, sworn statements, to the effect that people who were handling both products had not had any confusion either to themselves or among their customers.

The testimony of John Henry Parater is much like that of Herman Blumenthal, as will appear from the following (J.A. 13 and 14):

Q. Have you ever heard of Auto-Medic?

A. Well, I have to be perfectly honest with you. The name did not ring a bell to me when I first heard the name.

Q. You testified you have been selling Motor-Medic for approximately four years? A. That is correct.

Q. Have you ever known of an instance of confusion? A. To my knowledge, I do not.

I might elaborate on that, if the Court permits. Up until this thing came about I have not had one of my ten salesmen yet come to me and say anything about this particular product.

THE COURT: You didn't know anything about the Auto-Medic, is that it?

THE WITNESS: No, sir.

In his testimony, Z. Steve Giannakis does refer to the matter of confusion "between Motor-Medic and Auto-Medic", but that is as far as he goes. On the particular matter, his testimony (J.A. 16) reads, as follows:

Q. State whether or not you have ever known of an instance of confusion between Motor-Medic and Auto-Medic? A. I never have.

The witness Edward Younes was not questioned as to "instances of confusion or complaint or reports of conflict between the product of the plaintiff and that of Wynn Oil Company" (cf. Brief for Appellant, page 6, first paragraph). His questioning (J.A. 19) had

reference to the two products, Auto-Medic and Motor-Medic. His testimony (J. A. 19 and 20) on that score reads, as follows:

Q. I all [shall] ask you, please, whether or not you have ever known of any instance of confusion between these two products? A. I will have to answer no, unless you want me to elaborate a little bit.

Q. I would ask you to explain your answer further. A. Well, we have five salesmen traveling the road.

* * * *

THE WITNESS: We have five salesmen traveling, and if you are familiar with salesmen who are on commission basis, they are in every day complaining about competitive products or price and things of that nature. If they are on a commission basis they want to try to make every sale they can. We have handled Radiator Specialty Company products for a number of years, and particularly Motor-Medic, which is the issue before us. I haven't once from the time we have handled Motor-Medic and from the time that this Auto-Medic has been out ever received any complaints or any criticism from our salesmen who sell the product stating that they have had any confliction between their purchasers, which is the service station operator, garage or car dealer, any confusion between these two products; and that is how I base my decision.

In his testimony, the witness Horace Walker did not aver that he "had never known of any instance of confusion between the products involved herein" (*cf.* Brief for Appellant, page 6, second paragraph). His

testimony, like that of Edward Younes, has reference, so far as pertinent here, to the marks "Auto-Medic" and "Motor-Medic". It (J.A. 24) reads, as follows:

Q. Then I ask you whether or not you have ever known any instance of confusion between Radiator Specialty's marks, Motor-Medic, Trans-Medic and other marks and any other marks of competitors? A. Not to my knowledge.

Q. And that includes Auto-Medic as well as Motor-Medic? A. Yes, sir. It might help the Court to understand that in my position I have been closely connected with the outlets or the points from which these materials are distributed to the consumer, the motorists, the service stations, et cetera; and particularly I have been interested in the additive or chemical phase of the automotive service because there are so many of them and they do so many things; and it is rather difficult to keep track of them actually from the practical standpoint; but I have had ample opportunity during the past fifteen years to observe them.

Q. And you have found no confusion? A. None whatsoever.

SUMMARY OF ARGUMENT

1. The question raised, below, by appellant, as determinative of this case, is that of confusing similarity between "Motor-Medic" and "Auto-Medic". It, also, is the question raised by the facts of this case. Neither the tribunals of the Patent Office nor the District Court misconstrued the issue, and none erred.

2. The testimony offered by appellant does not suffice to overcome the concurring findings as to con-

fusing similarity by the tribunals of the Patent Office, and appellant has not shown that the further concurring finding of the District Court is clearly erroneous.

3. Side-by-side comparison correctly was rejected, below, as a test for confusing similarity.

4. "Medic" is not descriptive as applied to oil additives, and appellant has not, previously, so alleged. As applied to oil additives, "Medic" has no particular meaning.

5. The concurring findings, as to confusing similarity, by the three tribunals below, are sound and should stand.

ARGUMENT

1. At issue in this Court is the question of confusing similarity between "Motor-Medic" and "Auto-Medic" (as applied to identical products). That is the question that appellant raised before the Trademark Trial and Appeal Board as determinative of the question of confusing similarity between its mark as shown in the drawing of its application (J.A. 48) and the registered trademark of the Wynn Oil Company (J.A. 60). "It is applicant's contention", the Trademark Trial and Appeal Board noted (J.A. 54), "that 'MOTOR-MEDIC' and 'AUTO-MEDIC' neither look nor sound alike, and their meanings are sufficiently dissimilar to avoid confusion". Said contention was raised, as follows, by appellant in its brief before the Trademark Trial and Appeal Board (Plaintiff's Exhibit 1, page 23, final paragraph):

CONCLUSION

In view of the fact that MOTOR-MEDIC and AUTO-MEDIC do not create the same commercial impression, "auto" referring to an automobile and "motor" referring to a power plant, and in view of the suggestiveness of the term "medic" as applied to goods for improving performance and its common usage in the repair arts, purchasers are not likely to ascribe a common origin to goods under the trade-marks in question.

As will appear from the testimony of appellant's witnesses quoted in the foregoing "Counterstatement of the Case", appellant rested its case before the District Court on the same determinative question. Appellant ended its trial brief before that court in much the same way it ended its brief before the Trademark Trial and Appeal Board. The penultimate paragraph of "Plaintiff's Trial Brief" reads, as follows:

CONCLUSION

In view of the fact that MOTOR-MEDIC and AUTO-MEDIC do not create the same commercial impression, "auto" referring to an automobile and "motor" referring to a power plant, and in view of the highly suggestive nature of the term "medic" as applied to goods for improving performance, and its common usage in the repair arts, purchasers are not likely to ascribe a common origin to goods under the trademarks in question.

It ill becomes appellant to charge that "in denying registration the Patent Office and the District Court improperly relied solely upon the alleged similarity

of the terms 'MOTOR-MEDIC' and 'AUTO-MEDIC' disregarding the design features associated with the terms" (see question 2 of appellant's "Statement of Questions Presented" and Brief for Appellant, pages 9 to 13), when appellant invited such sole reliance by the Trademark Trial and Appeal Board and the District Court. It is significant that the identified question is more specific than points 1 and 2 of appellant's "Statement of Points" (Brief for Appellant, page 7), particularly in making reference to the Patent Office, and not limiting reference to the District Court. Appellant suggests (Brief, page 10, second, third and fourth paragraphs), with reference to the transcript as printed in the Joint Appendix, that during the course of the trial emphasis was placed by it on the design features of the composite mark of the Wynn Oil Company. Such suggested emphasis, it is submitted, did not, and could not, serve to apprise the District Court that the determinative question was other than that indicated in the quoted paragraph under "Conclusion" in "Plaintiff's Trial Brief". Contrary to the allegations of appellant (Brief, page 9, final paragraph, and page 10, first paragraph), the examiner did make reference (see J.A. 51, first paragraph: "and design") and the Trademark Trial and Appeal Board did give consideration (see J.A. 53, second paragraph: "and design") to the design features of the trademark registered to the Wynn Oil Company.

For the appellant to invite the Trademark Trial and Appeal Board and the District Court to adjudicate the question of confusing similarity between its

mark and the mark registered to the Wynn Oil Company on the basis of confusing similarity, or lack thereof, between "Motor-Medic" and "Auto-Medic," and for those two tribunals thus to adjudicate that question, is in line with accepted principles for determining confusing similarity. "In considering whether marks have a confusing similarity", the District Court noted (J.A. 61), citing *McKinnon & Co. v. HyVis Oils, Inc.*, 24 CCPA 1105, 88 F.2d 699, cited in *Esso Standard Oil Company v. Sun Oil Company et al.*, 97 U.S. App. D.C. 154, 229 F.2d 37, "three considerations are relevant — appearance, meaning, and sound". No tribunal has ever found, in connection with appellant's application for trademark registration, that the mark thereof and the mark of the reference registration are confusingly similar in sound and appearance; the implication of all prior decisions, rather, is that these two marks are not confusingly similar in sound and appearance. Here, as in such a case as *Hancock v. The American Steel & Wire Co. of New Jersey, Etc.*, 40 CCPA 931, 203 F.2d 737, the conclusion as to confusing similarity was predicated on identity, or near identity, in meaning. The only features of the marks in issue to which meaning can be ascribed are, of course, the words "Motor-Medic" and "Auto-Medic".

2. The examiner of trademarks (J.A. 49, 50, 51 and 52) and the Trademark Trial and Appeal Board (J.A. 53 and 54) concurred in finding that confusion would be likely. Their findings, which "must be accepted as controlling, unless the contrary is established by evidence 'which, in character and

amount carries thorough conviction' " (*Esso Standard Oil Company v. Sun Oil Company et al.*, 97 U.S. App. D.C. 154, 229 F.2d 37, and cases therein cited), receive support from the testimony, at the trial, of appellant's witness, Frank Marzullo (J.A. 28 and 29; see J.A. 62 and 63). Such testimony may be hearsay, as appellant suggests (Brief, page 14). However, it was elicited on direct examination, was not the subject of a motion to strike by appellant, and still stands. The testimony of appellant's remaining witnesses does not, it is submitted, measure up to the recited and required standard. Moreover, appellant has failed to establish that the further concurring finding of the District Court is clearly erroneous (*Esso Standard Oil Company v. Sun Oil Company et al.*, *supra*).

3. Appellant (Brief, pages 14 and 15) challenges the rejection by the District Court (J.A. 62, second paragraph), and hence, likewise, the rejection by the examiner (J.A. 51, final sentence), of side-by-side comparison of the terms "Motor-Medic" and "Auto-Medic" in determining whether concurrent use of these terms, on concededly identical goods (J.A. 8, lower third of page), would be likely to cause confusion, mistake or deception of purchasers (or prospective purchasers). The correctness of such rejection is demonstrated, however, by the decision of this Court in *McGraw-Hill Publishing Co., Inc., v. American Aviation Associates, Inc.*, 73 App. D.C. 131, 117 F.2d 293, elsewhere cited (page 11) in the Brief for Appellant. In that decision, this Court stated, in

connection with the matter of determining whether the words or designs of the parties created probable confusion, that

* * * *, it must be remembered that the law of trade marks is for the market place. Its purpose is to protect the several manufacturers in their respective spheres of public relations and to safeguard the consumer by helping him get what he thinks he wants. The method starts, therefore, with placing oneself in the position of a purchaser. One should look at the plaintiff's trade mark to obtain a general impression, the impression that would be carried in the memory, and then to observe, still as a buyer, the defendant's mark to determine if it is likely to be mistaken for this "memory trade mark" of the plaintiff.

Similar statements were made by this Court, earlier, in *Coca-Cola Co. v. Chero-Cola Co.*, 51 App. D.C. 27, 273 Fed. 755, and in *Patton Paint Company v. Orr's Zinc White, Limited*, 48 App. D.C. 221. In the former case, this Court said:

Of course, if the two marks were placed together, or if a person's attention was in some other way directed to them, there would be no difficulty in apprehending the difference between them. This, however, is not the way to make the test. Ordinarily the prospective purchaser does not carry more than a faint impression of the mark he is looking for. If the article offered to him bears a mark having any resemblance to the one he is thinking of, he is likely to accept it. He acts quickly. He is gov-

erned by a general glance. The law does not require more of him. *Patton Paint Co. v. Orr's Zinc White*, 48 App. D. C. 221.

In the latter case, this Court stated:

In *Pillsbury v. Pillsbury-Washburn Flour Mills Co.* 12 C.C.A. 432, 24 U.S. App. 395, 64 Fed. 841, 847, it was held that "the purchaser is required only to use that care which persons ordinarily exercise under like circumstances. He is not bound to study or reflect; he acts upon the moment. * * * The imitation need only to be slight if it attaches to what is most salient, for the usual inattention of a purchaser renders a good will precarious if exposed to imposition." Of course if the purchaser had an opportunity of comparing both marks, he would have no difficulty in discovering distinguishing features, but this is usually denied him. "He acts," as was said in the *Pillsbury Case*, "upon the moment."

4. Appellant (Brief, pages 15 and 16) now would have it that the term "medic" is descriptive, although before the District Court (see "Plaintiff's Trial Brief", "Conclusion", hereinbefore quoted) appellant made reference merely to its "highly suggestive nature" and before the Trademark Trial and Appeal Board (see Plaintiff's Exhibit 1, page 23, final paragraph, also hereinbefore quoted) to the "suggestiveness" thereof. "Medic," manifestly, is not descriptive as applied to oil additives, appellant's and the registrant's same goods. "As applied to oil additives", the District Court, correctly, found (J.A. 62, fourth sentence), the word 'Medic' has no par-

ticular meaning." The examiner in the Patent Office had, previously, also specifically so found (J.A. 51, second paragraph). What comfort appellant can discover, on the score of the alleged descriptiveness of the term "medic", in the three decisions it has cited (Brief for Appellant, pages 15 and 16), is not apparent. In *The Personal Products Corporation v. Allen Laboratories, Inc.*, the prefix "MED" in the appellee's mark, "MED-I-PAX", was held descriptive of the character or quality of appellee's goods: medicated vaginal suppositories, but the appellant's mark "MEDS", as applied to appellant's goods: unmedicated internal catamenial devices, was held not descriptive of the character or quality thereof. In *In re Medic Alert Company*, the Trademark Trial and Appeal Board did hold that "MEDIC ALERT", and a design, for an identification tag to be worn upon the person, "does not serve to indicate origin of the tags". However, that tag, intended to be worn by persons suffering from a medical disability, such as diabetes, epilepsy, hemophilia, or the like, was designed to carry, on the side which did not display the applicant's alleged mark, the "name and address of the wearer, and any medical information peculiar to him which might be of assistance to a doctor or other persons caring for or treating him in an emergency situation". Under such special circumstances, the Board necessarily was constrained to rule, as follows:

* * *, it is clearly apparent that what applicant seeks to register serves no purpose other than to direct attention to the fact that the

wearer of the tag on which it appears has a medical disability. In other words, the words "MEDIC ALERT", and the design, function only to alert the viewer as to some disability of the wearer.

And in *Scholl Mfg. Co., Inc., v. Schiff Co. et al.*, this Court expressed agreement with the view of the Assistant Commissioner of Patents that "the appellee-company's mark ["a composite mark consisting of the words 'Medico Pedic', printed in a peculiar script, and 'For Foot Health', both expressions being framed in rectangular lines and extending across a drawing of a shield] is not merely descriptive".

5. In initially refusing registration to appellant, on the basis of confusing similarity, the examiner of trademarks found (J.A. 49, antepenultimate sentence; J.A. 52, second sentence) the meaning or suggestive connotation of "Auto-Medic" and "Motor-Medic", as applied to automobile motor oil additives, to be nearly identical. In upholding the examiner, on the basis that confusion among purchasers would be more than likely to occur, the Trademark Trial and Appeal Board (J.A. 54) found that the "compound terms 'MOTOR-MEDIC' and 'AUTO-MEDIC', as applied to goods identical in kind, have the same meaning and create the same commercial impression". And in confirming both actions below, the District Court found in its "Memorandum Opinion" (J.A. 62, second paragraph) that "the use of these two terms would be very likely to cause confusion, mistake or deception to purchasers", and made (J.A. 43) the following rulings from the bench:

* * *, the Court cannot imagine any two terms that are so likely to cause confusion, considering the purpose for which they are used, which is practically identical, than AUTO-MEDIC and MOTOR-MEDIC. People refer to an automobile as an auto. Many others refer to an automobile as a motor.

Appellant, it is submitted, has not effectively assailed these findings. Most certainly, appellant has not sustained, with respect either to the findings in the Patent Office or the findings of the District Court, the heavy burdens specified in *Esso Standard Oil Company v. Sun Oil Company et al., supra.* The findings are sound and should stand.

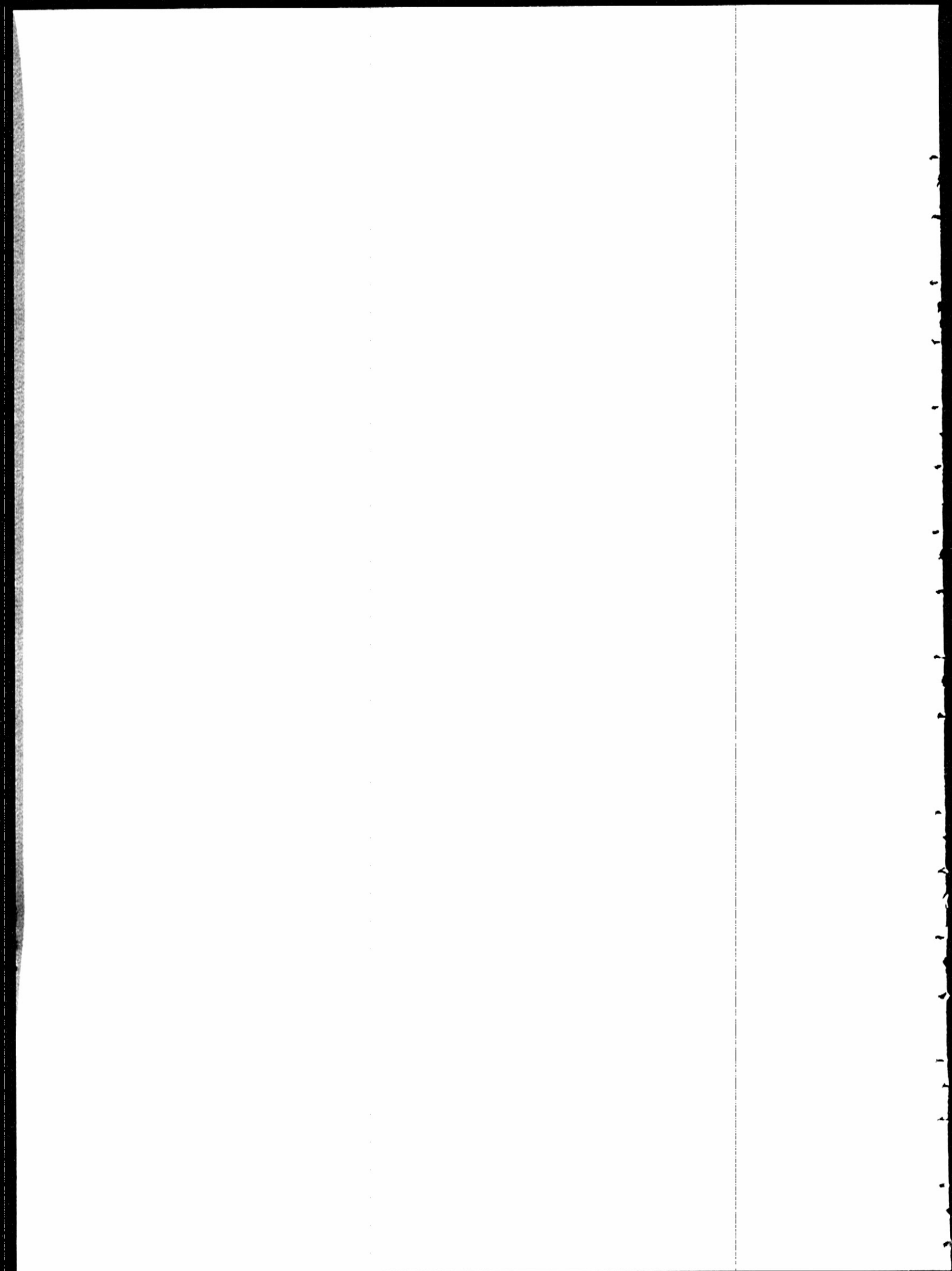
CONCLUSION

The decision of the District Court, it is submitted, is without reversible error, and it, accordingly, should be affirmed.

Respectfully submitted,

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Attorney for Appellee.

November, 1963.



REPLY BRIEF

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 18,087

RADIATOR SPECIALTY COMPANY,

Appellant,

v.

DAVID L. LADD,
Commissioner of Patents,

Appellee.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

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REPLY BRIEF

The brief of the Solicitor appears to be based on the astounding proposition that a plaintiff who attempts to have a true issue tried by the Court cannot complain if the Court's view of the issue is erroneously based on a defendant's interpretation of plaintiff's trial memorandum and its brief in the Patent Office.

The brief of the Solicitor also is remarkable in its statement of the question presented, representing to this Court that the word

portions of the marks are all that need to be considered, such being contrary to the statute. It is significant that the Solicitor does not attempt to discuss the true issue as presented in appellant's brief, involving the composite trademarks. This would seem to indicate that the Solicitor does not disagree with respondent's conclusion, relative to the composite marks, but instead undertakes to convince the Court that there is a technicality by which the Court is relieved from considering the true issue in the case.

By way of review this proceeding had its origin by the filing of an application to register a trademark. The application was rejected, based on another trademark registration, namely, Registration 651,646, Exhibit 1, R. 60. The issue thereby raised by this action of the Patent Office is whether plaintiff is entitled to have its trademark registered, and whether it was properly rejected based upon the aforesaid existing registration. The statutory question is set forth in Section 2(d) of the Trade-Mark Act of 1946 and includes the language whether the mark "so resembles a mark registered in the United States Patent Office."

The Examiner in the Patent Office received this application and it was his duty to consider and pass upon the same and he raised one question that because of the similarity of the word portion of the mark sought to be registered and that of the prior registration allowance of the application for registration would be improper. The Patent Office in the past mistakenly has relied upon word portions of marks where design features were present, such mistakes having sometimes been corrected on appeal, as in Cooperative Quality Marketing Company, Inc. v. Dean Marketing Company, 314 F.2d 552 (CCPA, 1963). Since this erroneous position has been taken by the Patent Office, it has led applicant to argue in a similar vein, although recognizing that this was not the true issue. The Solicitor apparently persists in this view (Appellee's Brief, p. 10, lines 2-6, 24-26) despite repeated contrary holdings by this Court (see our Brief, pp. 11, 12). If there has been a

mistake it has been by the Patent Office referring only to the word portions of the marks, and the Solicitor in grasping for a reason to defeat an application for registration may not reasonably hold applicant defeated by a technicality, particularly since in the District Court in the opening statement by applicant (JA 6, 7) there was emphasized the over-all design features of the marks and every effort was made to have the case tried upon the correct issue.

The Patent Office brief states that it ill becomes appellant to charge that the Patent Office and the District Court disregarded the design features when appellant invited such sole reliance. No justification whatever can be found for such position by the Patent Office, and there is no denial that appellant called the matter to the Court's attention in its opening statement.

Apparently the Patent Office seeks to rely upon a double standard. For example, in Ballew v. Watson, 110 App. D.C. 162, 290 F.2d 353 (1961), the Patent Office raised an entirely new issue after appellant had completed its testimony.

It appears settled (35 U.S.C. 145) that an action in the District Court is a trial "de novo" and is to be "prepared and heard upon all competent evidence adduced and upon the whole merits" and not merely on the record in the Patent Office. Zenith Radio Corp. v. Ladd, Comm. Patents, ___ App. D.C. ___, 310 F.2d 859 (1962). Appellant might urge here that he has been denied due process because, having made an election, not to the Court of Customs and Patent Appeals, but to the District Court, and both the Solicitor and the District Court having been acting according to the rules of the Court of Customs and Patent Appeals, there has been no suitable adjudication of the issue before the Court. The distinction between such a trial de novo and a technical appeal has been so well recognized heretofore that no further citation of authority is believed to be necessary.

CONCLUSION

The Solicitor on behalf of the appellee apparently concedes that the District Court failed to consider the composite trademarks involved and mistakenly urges this Appellate Tribunal to deny justice to plaintiff who sought to present the correct issue to the Court as indicated in its opening statement. Appellee bases its case entirely upon the incorrectly circumscribed issue and has offered nothing to refute the force of appellant's argument in connection with the true issue.

Respectfully submitted,

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